

***United States Court of Appeals
for the Second Circuit***



**APPELLANT'S
APPENDIX**

ORIGINAL

75-7483

United States Court of Appeals

For the Second Circuit.

WALLACE CLARK & CO., INC.,

Plaintiff-Appellant,

v.

ACHESON INDUSTRIES, INC.,

Defendant-Appellee.

*On Appeal From The United States District
Court For The Southern District Of New York*

Appellant's Appendix

PAUL H. BLAUSTEIN
HOPGOOD, CALIMAFDE, KALIL,
BLAUSTEIN & LIEBERMAN
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PERTINENT DOCKET ENTRIES

6-28-74 Complaint and Summons filed.
Defendant's Answer to
Complaint.

2-13-75 Plaintiff's Reply to Counter-
claim filed.

2-13-75 Defendant's Amended Answer
and Counterclaim filed.

3-7-75 Plaintiff's Affidavit and
Notice of Motion to stay discovery.

2-19-75 Memo on motion.

3-7-75 Plaintiff's motion for stay
is denied, pursuant to agreement by parties at
oral argument.

2-26-75 Defendant's memo in opposition
to plaintiff's motion under Rule 60 and for summary
judgment under plaintiff's second cause of action.

4-28-75 Defendant's exhibits, affidavit
and notice of cross-motions for modification of
consent decree and for summary judgment, filed in
chambers.

4-28-75 Plaintiff's notice of motion
and motion to dismiss defendant's second cause
of action set forth in the counterclaim.

B

4-28-75 Opinion #42320..For reasons indicated, the consent decree entered in the prior action between the parties is to be accorded res judicata effective with respect to the adjudication of (1) the validity of the patent, and (2) infringement of the patent by plaintiff's product Meta-Tef 530. As to plaintiff's further motion for summary judgment under its second cause of action, the foregoing disposition does not foreclose plaintiff from asserting non-infringement of defendants patent by other products manufactured by it, which products were not the subject of the prior consent decree. Since there is disputed issues, the motion is denied. Weinfeld, J.

7-21-75 Plaintiff's notice of motion for reconsideration and clarification of this Court's Opinion of 4-28-75. Summary judgment and leave to appeal.

7-21-75 Opinion #42826..Motion for reconsideration and clarification is denied of Court Opinion dated 4-28-75. The court therefore directs entry of judgment in favor of defendants as to the third count of the complaint pursuant to Rule 54 (b). Plaintiff's motion to dismiss second counterclaim is granted. Plaintiff's motion for summary judgment as to its second cause of action alleging patent misues is denied. Weinfeld, J.

8-18-75 Notice of Appeal.

COMPLAINT

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

-----X
WALLACE CLARK & COMPANY, INC., :
Plaintiff, : Civil Action No.
v. : 74 CIU. 2812
ACHESON INDUSTRIES, INC. :
Defendant. :
-----X

COMPLAINT

Plaintiff, Wallace Clark & Company, Inc. (hereinafter Wallace Clark), for its complaint against defendant Acheson Industries, Inc. (hereinafter Acheson) alleges:

FIRST CAUSE OF ACTION

1. Plaintiff, Wallace Clark & Company, Inc., has a principal place of business at 1125 Fifth Avenue, New York, N.Y. American Metaseal Company is a division of plaintiff Wallace Clark.
2. On information and belief, defendant Acheson is a Michigan corporation and has a regular and established place of business and a principal office at 420 Lexington Avenue, New York, N.Y. On information and belief, defendant is doing business and is licensed to do business in the State of New York.
3. This suit arises out of an actual controversy between the parties as to (1) plaintiff's right to contest the validity of defendant's Letters Patent No. 2,976,257, issued March 21, 1961 for "Re-dispersible Dispersion of Polytetrafluoroethylene" by Harold J. Dawe and Earl L. Youse and (2) Plaintiff's rights as to the License Agreement between the parties (Ex. A annexed), and the Consent Decree (Ex. B annexed) particularly plaintiff's

right to terminate, notwithstanding paragraphs 14 and 16 of said license which prohibit termination and paragraph 2b which requires payment of minimum royalties.

4. Notwithstanding the Consent Decree (Ex. B) and said license, Wallace Clark claims, and it is disputed by the defendant Acheson, that Wallace Clark has a right to contest validity, that it has a right to contest issues of infringement, particularly products made other than a 530 identified in said decree and that it has a right to terminate said license agreement.

5. Acheson has brought suit on said license in the County Court, Wayne County, Michigan (copy of Complaint annexed as Ex. C) which has brought into issue the effect of the consent decree (Ex. B) entered by this Court as well as seeking to enforce the minimum royalties provisions.

6. Jurisdiction is conferred on this Court pursuant to the Declaratory Judgment statutes (28 U.S.C. 2201, 2202) providing that in a case of actual controversy within its jurisdiction, any court of the United States may declare the rights and legal relations of interested parties; upon the patent laws of the United States [28 U.S.C. 1338(a)] granting the district courts original jurisdiction of any civil action arising under any act of Congress relating to patents.

7. Venue is predicated upon 28 U.S.C. 1391 permitting a corporation to be sued in any judicial district in which it is licensed to do business or is doing business, defendant Acheson being licensed or doing business within the State of New York

8. Plaintiff has the right to and has cancelled said License Agreement.

9. Royalties owing to Plaintiff have been paid in the amount due in the years 1972 and 1973.

10. Plaintiff, Wallace Clark claims and Defendant Acheson disputes, Wallace Clark's right to contest the validity of Plaintiff's patent 2,976,257.

11. Wallace Clark has a right to allege invalidity as a defense to any suit or claim for royalty payments, notwithstanding the License Agreement, Ex. A, or the Consent Decree, Ex. B.

12. Wallace Clark has a right to allege non-infringement as a defense in any suit or claim for royalty payment and has a right to challenge the valid scope of the claims of 2,976,257, notwithstanding the License Agreement or Consent Decree.

13. That the products which Wallace Clark has been selling from January 1, 1974 do not infringe the patent in suit nor are they covered by the License Agreement and no royalties are due.

14. That the patent suit is invalid and the claims thereof cannot be construed so broadly as to be valid and still cover any of the Defendant's products sold since January 1974.

15. Plaintiff alleges that said patent is not now being infringed or that it has ever been infringed.

16. Plaintiff alleges that said patent has never infringed any claim actually adjudicated on the merits as valid.

17. That the minimum royalty clause, ¶2 of the License Agreement is a patent misuse since products currently sold by Wallace Clark do not infringe upon any of the claims of the said patent, and to require royalty payments for products outside the claims is an improper extension of the patent monopoly under the special circumstances here presented, and that such minimum royalties are an undue and illegal

extension of the patent monopoly and the license is unenforceable.

SECOND CAUSE OF ACTION

18. The License Agreement has been a violation of § 1 of the Sherman Act, Antitrust Laws, 15 U.S.C. § 1 and a patent misuse ab initio from January 1, 1972 because of the inclusion of clauses 14 and 16 preventing Wallace Clark from terminating the License during the life of the patent.

19. Defendant Wallace Clark, has paid royalties in 1972 and 1973, after said misuse in the amounts of \$4,500 for 1972 and \$10,814.91 for 1973, totalling \$15,314.91, which amount is due Defendant as a result of said misuse, and violation of 15 U.S.C. § 1.

20. That the clause of the License Agreement §§ 14, 16, to the effect that the Agreement may not be cancelled or terminated by Licensee prior to March 21, 1978, requires the Defendant to pay royalties to March 21, 1978, without regard to infringement or Wallace Clark's right to cancel the license or contest the validity of the claims of the patent, or determine the valid scope of any claims in contesting infringement, each or all in violation of Defendant's rights under Lear Inc. v. Adkins, 395 U.S. 653 (1969); that such rights had been recognized at law since 1970 and prior to the License Agreement, Ex. A, which was effective January 1, 1972; and that such clause constitutes patent misuse ab initio to January 1, 1972 and a violation of § 1 of the Sherman Act, Antitrust Laws as an unlawful, unreasonable contract in restraint of trade.

THIRD CAUSE OF ACTION

21. Upon information and belief, said patent is invalid for one or more of the following reasons:

(a) The subject matter of the patented invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by said patentee;

(b) The subject matter of the patented invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country more than one year prior to the date of the application for said patents in the United States;

(c) The subject matter of the patented invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by said patentee;

(d) The patentee did not himself invent the said subject matter;

(e) The differences between said subject matter and the prior art are such that the said subject matter would have been obvious at the time the alleged inventions were made to a person having ordinary skill in the art to which said patent pertains within the meaning of 35 U.S.C. § 103;

(f) The patent does not comply with 35 U.S.C. § 112.

WHEREFORE Plaintiff requests:

1. That it be declared that said License Agreement has been terminated and cancelled.

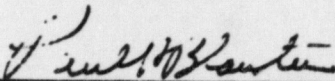
2. That it be declared that Wallace Clark has the right to contest the validity of the patent 2,976,257.

3. That it be declared that Wallace Clark has the right to contest infringement and that Wallace Clark has not infringed said patent, at least since January 1, 1974.

4. That the License Agreement is unenforceable because of misuse.

5. That relief be granted to Plaintiff Wallace Clark in the amount of \$15,314.91, trebled, plus costs, attorney fees for Defendant Acheson's violation of 15 U.S.C. § 1 and for misuse.

6. Such other relief as may be proper.



Paul H. Blaustein
Sandoe, Houghton & Calimafde
60 East 42nd Street
New York, New York 10017
(212) 986-2480
Attorney for Plaintiff

AGREEMENT

This agreement to be effective as of January 1, 1972,

BY AND BETWEEN

ACHESON INDUSTRIES, INC.
a corporation of Michigan
having a place of business at
Michigan National Bank Building
Port Huron, Michigan 48060

hereinafter called LICENSOR

AND

WALLACE CLARK & COMPANY LTD.
having a place of business at
445 Park Avenue
New York, New York 10022
and its related divisional companies
AMERICAN METASEAL COMPANY
18255 Weaver Avenue
Detroit, Michigan 48228 and
AMERICAN METASEAL COMPANY
509 Washington Avenue
Carlstadt, New Jersey 07072

hereinafter called LICENSEE

WITNESSETH:

WHEREAS, LICENSOR is the owner of the following United States Letters Patent relating to certain dispersion compositions hereinafter referred to as "LICENSED PRODUCTS":

<u>U. S. Patent No.</u>	^{A8} <u>Issue Date</u>	<u>Title</u>
2,976,257	March 21, 1961	Re-Dispersible Dispersion of Polytetrafluoroethylene

WHEREAS, LICENSOR is engaged in the manufacture and sale of products governed by said letters patent;

WHEREAS, LICENSEE desires a limited, non-exclusive license, as defined hereinafter, to manufacture, use and sell such LICENSED PRODUCTS and LICENSOR is desirous of licensing LICENSEE for the manufacture, use and sale of such LICENSED PRODUCTS;

NOW THEREFORE, in consideration of the mutual covenants and agreements herein contained it is agreed by and between the parties hereto as follows:

1. LICENSOR hereby grants to LICENSEE a limited, non-exclusive right and license under the claims of the aforesaid United States Letters Patent, to manufacture, use and sell said LICENSED PRODUCTS.

2. LICENSEE agrees to pay to LICENSOR:

(a) A running royalty of five percent (5%) on:
(i) the net selling price of all sales by LICENSEE of LICENSED PRODUCTS to third parties; and, (ii) the market value of LICENSED PRODUCTS used or applied internally within LICENSEE'S own facilities calculated based on LICENSEE'S average prevailing external market net selling price as determined by a mutually agreed upon public accounting firm (such as Ernst & Ernst or other mutually agreed upon firm).

A9

(b). A fixed yearly minimum royalty according to the

following schedule:

For the calendar year 1972	--	\$4,500.00
For the calendar year 1973	--	\$6,250.00
For the calendar year 1974 and each calendar year thereafter	--	\$7,500.00

Said fixed yearly minimum royalty shall be credited against the running royalty due under Paragraph 2(a)

3. LICENSEE agrees to make payment of the fixed minimum royalties quarterly in advance on the first day of January, April, July, and October, beginning as of January 1, 1972; and the running five percent (5%) royalty in excess of the fixed royalty for any calendar quarter shall be payable quarterly in arrears within thirty (30) days following the end of each calendar quarter.

4. LICENSEE shall keep proper books of account showing manufacture, sales and/or usage of the LICENSED PRODUCTS under this agreement and LICENSEE agrees to report in writing to LICENSOR by the thirtieth (30th) day of the month following each calendar quarter the total dollar sales of LICENSED PRODUCTS sold by it during the preceding calendar quarter and the value of internal usage of the LICENSED PRODUCTS by LICENSEE calculated on the basis of the LICENSEE average prevailing external market net selling price applied to determine royalties due for the LICENSED PRODUCTS used internally by LICENSEE. The written report by LICENSEE to LICENSOR following each calendar quarter shall be the basis for computing the running royalty referred to in Paragraph No. 2(a) above, subject to adjustment following the year-end audit by the mutually agreed upon public accounting firm at LICENSEE'S expense of what external prevailing net selling price should be assigned to internal usage of the LICENSED PRODUCTS by LICENSEE.

5. Within thirty (30) days following each calendar quarter, LICENSEE will submit said written report giving the total dollar sales and usage of LICENSED PRODUCTS subject to royalty under this agreement for the calendar quarter being reported and will accompany such quarterly report with payment of the royalty then due.

6. The LICENSED PRODUCTS shall be considered sold when billed out, or if not billed out when delivered, used, or paid for before delivery.

7. LICENSOR shall have access to the books and records of LICENSEE at all reasonable times to check the amount of sales or usage of LICENSED PRODUCTS hereunder by LICENSEE from time to time, provided however, that LICENSEE may at its election and expense substitute for LICENSOR'S examination a certificate of a mutually agreed upon firm of certified public accountants as to the amount of said sales or usage of LICENSED PRODUCTS and as to any other figures that will determine the amount of royalties payable thereon. LICENSOR will not require an examination or such certified statement more often than once a year.

8. LICENSEE agrees that LICENSED PRODUCTS used or sold by LICENSEE and labels and literature of the LICENSEE which refer to the LICENSED PRODUCTS, shall bear a clear reference to the U. S. Letters Patent licensed hereunder in a form acceptable to the LICENSOR. LICENSEE agrees that it will not use or refer to LICENSOR'S name in connection with LICENSEE'S use or sale of the LICENSED PRODUCTS. The marking used by the LICENSEE shall be generally as follows:

"Licensed under U. S. Patent 2,976,257"

due from LICENSOR to LICENSOR as of January 1, 1972, April 1, 1972, and July 1, 1972, will be payable by LICENSEE to LICENSOR upon the execution of this agreement in the amount of thirty-three hundred seventy-five dollars (\$3,375.00).

10. In the event that LICENSEE fails to comply with the terms of reports and royalty payments specified herein and so often as the same shall happen, or breaches any other material provisions of this agreement, LICENSOR may at its option, by giving sixty (60) days notice in writing, specifying the breach complained of, terminate this agreement and the license granted hereby, provided however, that if the breach complained of shall be corrected by LICENSEE within thirty (30) days after the mailing of said notice then this agreement shall remain in full force and effect.

11. LICENSEE and LICENSOR hereby agree that said written reports (per Paragraphs 4 and 5) concerning sales and usage of LICENSED PRODUCTS will report sales and usage of LICENSEE'S Products No. 530 and No. 730 and LICENSED PRODUCTS in combined amounts; and, that when the first instance occurs of these combined amounts requiring a royalty payment in excess of the required yearly minimum royalty [under Paragraph 2(b)], then LICENSEE agrees that at that time it will disclose the recipe of its Product No. 730 (Meta-Tef 730) to LICENSOR'S counsel, Harness, Dickey & Pierce, on a lawyer confidential basis.

12. Notice as herein provided shall be in writing and shall mean the placing of the notice in the mails, registered-return, postage prepaid to the party being notified at the address above given or at such other address designated by the parties hereto, or by otherwise delivering to the other party such notice.

13. The license herein granted is non-transferable without the prior written consent of LICENSOR first had and obtained,

which shall not be unreasonably withheld, and this agreement shall be binding upon and inure to the benefit of any such approved transferee of LICENSEE and the successors and assigns of LICENSOR. The license herein granted may be assigned by LICENSEE without LICENSOR'S consent to any company which shall succeed to substantially all of its business and property and to all companies now or hereafter owned or controlled by said LICENSEE or its successor or assigns.

14. Unless previously terminated in accordance with the terms hereof this agreement and the license herein granted shall extend for the full term of the United States Letters Patent 2,976,257 and shall terminate at the expiration of said Patent No. 2,976,257 on March 21, 1978.

15. That in the event LICENSEE becomes insolvent or executes an assignment for the benefit of creditors or files a petition in bankruptcy or has a petition in bankruptcy filed against it, LICENSOR may terminate this agreement by giving notice thereof to LICENSEE.

16. This agreement may not be canceled by LICENSEE prior to March 21, 1978.

17. Promptly following the execution of this agreement the LICENSEE and LICENSOR agree to secure the dismissal of Civil Action No. 71-5655 in the United States District Court for the Southern District of New York in accordance with the terms of the attached Appendix A dismissal document.

18. It is agreed that this license grants LICENSEE no rights to LICENSOR'S know-how, trademarks, or any other of LICENSOR'S property rights than those specified hereinabove.

19. This agreement shall be construed under the laws of the State of Michigan.

Signed at Port Huron
this 10 day of July, 1972.

WALLACE CLARK & COMPANY LTD.

By [Signature]
Its: President

ATTEST:

[Signature]
Signed at _____
this _____ day of _____, 1972.

AMERICAN METASEAL COMPANY

By _____
Its: _____

ATTEST:

Signed at Port Huron, Michigan
this 13th day of SEPTEMBER, 1972.

ACHESON INDUSTRIES, INC.

ATTEST:

[Signature]
By [Signature]
Its: SECRETARY & TREASURER

On this 11th of August, 1972 before me personally came JOHN HOYT STOCUTY, to me known, who being by me duly sworn, did depose and say that he is Chairman of the Board of WALLACE CLARK & COMPANY LTD., the corporation described in and which executed the above instrument; that he knows the seal of said corporation; that the seal affixed to the said instrument is such corporate seal, and that it was so affixed thereto by order of the Board of Directors of said corporation and that he signed his name thereto by like order.

Kathryn A. Yeomans
Notary Public

KATHRYN A. YEOMANS
Notary Public, State of New York
No. 31-8072955
Qualified in New York County
Commission Expires March 30, 197

STATE OF
COUNTY OF

Michigan
St. Clair

) ss.:

On this 13th day of September, 1972, before me personally came Donald L Keith, to me known, who being by me duly sworn, did depose and say that he is Sec. & Treas. of ACHESON INDUSTRIES, INC., the corporation described in and which executed the same instrument; that he knows the seal of said corporation; that the seal affixed to the said instrument is such corporate seal, and that it was so affixed thereto by order of the Board of Directors of said corporation and that he signed his name thereto by like order.

Robert S. Lapp
Notary Public
ROBERT S. LAPP

Notary Public, St. Clair County, Mich.
My commission expires Aug. 7, 1973

WALLACE CLARK & COMPANY LTD.,

Plaintiff,

v.

ACHESON INDUSTRIES, INC.,

Defendant.

Civil Action No.
71-5655CONSENT DECREE

As between the parties, by their counsel stipulating hereto, and the Court being fully advised in the matter, it is hereby ordered and decreed as follows:

1. United States Letters Patent 2,976,257 in suit is valid and is infringed by plaintiff's manufacture, use and sale of its product Meta-Tef 530.
2. The plaintiff having taken a license under defendant's United States Letters Patent 2,976,257, the above-entitled action is hereby dismissed, with each party to bear its own costs and attorney fees.
3. This decree may not be cited as an adjudication of contested issues, nor be used for advertising purposes.

Dated: October 6, 1972

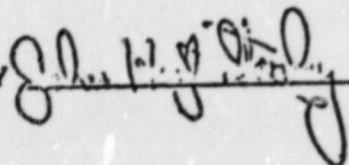
John M. Cannella
United States District Judge

(EXHIBIT B)

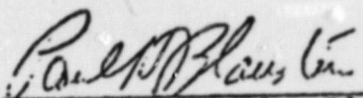
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STIPULATION

Entry of the foregoing Consent Decree is hereby approved
and stipulated to by the parties.

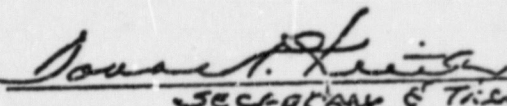
WALLACE CLARK & COMPANY LTD.,
Plaintiff

By 

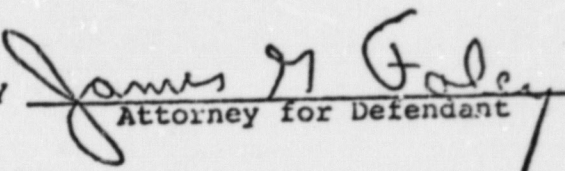
SANDOE, HOPGOOD & CALIMAFDE

By 
Attorney for Plaintiff

ACHESON INDUSTRIES, INC.,
Defendant

By 
Secretary & Clerk

PENNIE, EDMONDS, MORTON, TAYLOR
AND ADAMS

By 
Attorney for Defendant

IN THE CIRCUIT COURT
FOR THE COUNTY OF WAYNE
STATE OF MICHIGAN

ACHESON INDUSTRIES, INC.)
a corporation of Michigan,)
Plaintiff,)
v.)
WALLACE CLARK & CO., LTD)
a corporation of New York,)
Defendant.)

Civil Action

No. 74-012650 -CK

BENJAMIN D. BURDICK
P 11392

Michael Dinnin (P 12801)
Attorney for Plaintiff

COMPLAINT

1. This is an action for breach of contract and for an accounting.
2. Plaintiff, Acheson Industries, Inc., (hereinafter sometimes referred to as "ACHESON") is a Michigan corporation, having a place of business at 19675 West Ten Mile Road, Southfield, Michigan.

3. Defendant, WALLACE CLARK & COMPANY, LTD.

(hereinafter sometimes referred to as "WALLACE CLARK") is a New York corporation, having its principal place of business at 445 Park Avenue, New York, New York, and is licensed to do business in Michigan having as its registered agent for service The Corporation Company, 615 Griswold, Detroit, Michigan. Defendant also has a division named American Metaseal company of Detroit which division has a place of business at 18255 Weaver Avenue, Detroit, Michigan and upon information and belief is a wholly owned division of Defendant.

4. On or about September 13, 1972, Plaintiff

ACHESON, the owner of the entire right, title and interest in and to United States Letters Patent No. 2,976,257 (hereinafter sometimes referred to as the "Licensed Patent"), entered into a written Agreement (Exhibit A herewith) with Defendant WALLACE CLARK under which Plaintiff ACHESON granted to Defendant WALLACE CLARK a non-exclusive license to make, use and sell patented coating compositions throughout the United States, its territories and possessions for the remaining life of said Licensed Patent. Said Agreement was in consideration of a fixed yearly minimum royalty payment from WALLACE CLARK to ACHESON for the calendar year 1972 and each calendar year thereafter until the expiration of the Licensed Patent. For the calendar year 1974 and each year thereafter the fixed minimum payment is in the amount of seventy-five hundred dollars (\$7,500.00). Said Agreement was also in

consideration of a royalty in the sum of five per cent (5%) of the selling price by WALLACE CLARK of all coating compositions set forth in said Licensed Patent.

5. The aforesaid Agreement was negotiated in settlement of an action involving patent infringement in the United States District Court for the Southern District of New York, Civil Action No. 71-5655, and one of the specific conditions of said Agreement provided for the entry of a final judgment by Consent Decree (Exhibit B herewith) in said action declaring said Licensed Patent to be valid in law, and infringed, as between Plaintiff and Defendant.

6. Plaintiff ACHESON has duly performed all of the obligations required by it to be performed under said Agreement, and said Agreement has been and continues to be in full force and effect.

7. Defendant WALLACE CLARK and its division American Metaseal has manufactured, used or sold the said licensed coating compositions (under its product names Meta-Tef 530 and Meta-Tef 730) but since January 1, 1974 and continuing to date, Defendant has breached the terms of said Agreement by refusing and failing to account for and make payments of said fixed minimum royalties, which fall due for payment on a quarterly basis in advance on the first day of January, April, July and October, with one-fourth (1/4) of the yearly minimum payment being due on each of said days in accordance with the terms of said Agreement.

8. Defendant upon information and belief is also manufacturing, using or selling a recently formulated one package resin binder-fluorocarbon particle containing coating composition while refusing and failing to account for and make payments of royalties thereon. Defendant has also breached the terms of said Agreement by failing to submit required written royalty reports and by failing to submit formulation recipe information to Plaintiff as required in the Agreement.

WHEREFORE, Plaintiff demands judgment as follows:

- A. That Defendant be adjudged liable to Plaintiff in the amount of all royalties past due and owing under said Agreement to date of judgment, together with interest from each respective due date, including any royalties and interest due by reason of sales or usage of said one package coating composition manufactured, used or sold by Defendant.
- B. That Defendant be required to pay to, and be adjudged liable to Plaintiff for the present worth of all the remaining yearly fixed minimum payments up to the expiration of the patent on March 21, 1978, in the approximate amount of \$27,893.84, as well as the already past due fixed minimum payments in the amount of \$3,750.00, for a total of \$31,643.84.
- C. That the Defendant be required to account to Plaintiff as to the quantities of coating compositions manufactured, used or sold by it, under said Agreement and to provide all such information as is needed to compute the exact amount of royalties past due and owing together with interest under said Agreement.

- D. That Defendant be adjudged liable to Plaintiff for all of Plaintiff's costs, attorneys fees, and disbursements of this action, and
- E. That such other relief be awarded to Plaintiff as is equitable and just.

ACHESON INDUSTRIES, INC.

By Michael Dinnin
Michael Dinnin, Jr.
HARNES, DICKEY & PIERCE
1500 North Woodward
Birmingham, Michigan 48011
Phone: 642-7000

Attorneys for Plaintiff

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

WALLACE CLARK & COMPANY, INC.,)	
)	
Plaintiff,)	
)	
v.)	Civil Action No.
)	74 CIV. 2812 EW
ACHESON INDUSTRIES, INC.,)	
)	
Defendant.)	
)	

ANSWER

Now comes the defendant, Acheson Industries, Inc., and answers the complaint herein as follows, without waiver of its right to plead, move, or otherwise request this Court for a stay of proceedings herein.

1. Upon information and belief paragraph 1 of the complaint is admitted.
2. Paragraph 2 of the complaint is denied.
3. Paragraph 3 of the complaint is denied.
4. Concerning paragraph 4 of the complaint defendant admits that plaintiff's claims therein are disputed.
5. Paragraph 5 of the complaint is admitted.
6. Paragraph 6 of the complaint is admitted.
7. Paragraph 7 of the complaint is admitted.
8. Paragraph 8 of the complaint is denied in that it is defendant's position that plaintiff cannot legally cancel the license settlement agreement (Exhibit A with the complaint herein).

9. Defendant is without sufficient information to admit or deny paragraph 9 of the complaint and accordingly the same is denied.

10. With regard to paragraph 10 of the complaint defendant denies that plaintiff has a right to contest the validity of the licensed patent No. 2, 976, 257 because of the earlier Consent Judgment entered in this Court (Civil Action No. 71-5655, entered October 16, 1972) which specifically held said patent to be valid and infringed.

11. Paragraph 11 of the complaint is denied.

12. Paragraph 12 of the complaint is denied.

13. Paragraph 13 of the complaint is denied.

14. Paragraph 14 of the complaint is denied.

15. Paragraph 15 of the complaint is denied.

16. Paragraph 16 of the complaint is denied.

17. Paragraph 17 of the complaint is denied.

18. Paragraph 18 of the complaint is denied.

19. Defendant admits that a certain amount of royalties have been paid by Wallace Clark in 1972 and 1973, but the remainder of paragraph 19 of the complaint is denied.

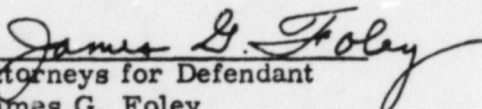
20. Paragraph 20 of the complaint is denied.

21. Paragraph 21 of the complaint and each of the
sub-paragraphs thereof is denied.

Respectfully submitted,

PENNIE & EDMONDS

By


Attorneys for Defendant
James G. Foley
330 Madison Avenue
New York, New York 10017
(212) 986-8686

Of Counsel:

Michael Dinnin, Jr.
Harness, Dickey & Pierce
1500 N. Woodward
Birmingham, Michigan 48011
(313) 642-7000

AMENDED ANSWER AND COUNTERCLAIM

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

WALLACE CLARK & COMPANY, INC.,

Plaintiff,

v.

Civil Action No. 74 CIV. 2812 EW

ACHESON INDUSTRIES, INC.,

Defendant.

AMENDED ANSWER AND COUNTERCLAIM

Now comes defendant, through its counsel, and amends its Answer herein as follows:

After paragraph No. 21 of the Answer insert the following:

COUNTERCLAIMFirst Cause of Action

22. This is an action for breach of contract and for an accounting.

23. Defendant Acheson Industries, Inc., (hereinafter sometimes referred to as "ACHESON") is a Michigan corporation, having a place of business at 19675 West Ten Mile Road, Southfield, Michigan.

24. Plaintiff, WALLACE CLARK & COMPANY (hereinafter sometimes referred to as "WALLACE CLARK") is a New York corporation, having its principal place of business at 445 Park Avenue, New York, New York. Plaintiff also has a division or entity named American Metaseal of Detroit which division has a place of business at 12855 Weaver Avenue, Detroit, Michigan and upon information and belief is a wholly owned division of Plaintiff.

25. On or about September 13, 1972, Defendant ACHESON, the owner of the entire right, title and interest in and to United States Letters Patent No. 2,976,257 (hereinafter sometimes referred to as the "Licensed Patent"), entered into a written Agreement (Exhibit A herewith) with WALLACE CLARK under which ACHESON granted to WALLACE CLARK a non-exclusive license to make, use and sell patented coating compositions throughout the United States, its territories and possessions for the remaining life of said Licensed Patent. Said Agreement was in consideration of a fixed yearly minimum royalty payment from WALLACE CLARK to ACHESON for the calendar year 1972 and each calendar year thereafter until the expiration of the Licensed Patent. For the calendar year 1974 and each year thereafter the fixed minimum is in the amount of seventy-five hundred dollars (\$7,500.00). Said Agreement was also in consideration of a royalty in the sum of five per cent (5%) of the selling price by WALLACE CLARK of all coating compositions set forth in said Licensed Patent.

26. The aforesaid Agreement was negotiated in settlement of an action involving patent infringement in the United States District Court for the Southern District of New York, Civil Action No. 71-5655, and one of the specific conditions of said Agreement provided for the entry of a final judgment by Consent Decree (Exhibit B herewith) in said action declaring said Licensed Patent to be valid in law, and infringed, as between Plaintiff and Defendant.

27. ACHESON has duly performed all of the obligations required by it to be performed under said Agreement, and said

Agreement has been and continues to be in full force and effect.

28. WALLACE CLARK and/or its division American Metaseal has manufactured, used or sold the said licensed coating compositions (under its product names Meta-Tef 530 and Meta-Tef 730) but since January 1, 1974 and continuing to date, Plaintiff has breached the terms of said Agreement by refusing and failing to account for and make payments of said fixed minimum royalties, which fall due for payment on a quarterly basis in advance on the first day of January, April, July and October, with one-fourth (1/4) of the yearly minimum payment being due on each of said days in accordance with the terms of said Agreement.

29. Plaintiff WALLACE CLARK upon information and belief is also manufacturing, using or selling a recently formulated one package resin binder-fluorocarbon particle containing coating composition while refusing and failing to account for and make payments of royalties thereon. WALLACE CLARK has also breached the terms of said Agreement by failing to submit required written royalty reports and by failing to submit formulation recipe information to ACHESON as required in the Agreement.

Second Cause of Action

30. Paragraphs 23 through 29 are repeated herein.

31. That Plaintiff WALLACE CLARK is in contempt of said earlier decree rendered by this Court (Exhibit B herewith) and that WALLACE CLARK has carried out its actions in willful violation of said decree.

WHEREFORE, Defendant ACHESON demands judgment on its counterclaim as follows:

- A. That WALLACE CLARK be adjudged liable to ACHESON in the amount of all royalties past due and owing under said Agreement to date of judgment, together with interest from each respective due date, including any royalties and interest due by reason of sales or usage of said one package coating composition manufactured, used or sold by WALLACE CLARK.
- B. That WALLACE CLARK be required to pay to, and be adjudged liable in damages to ACHESON for the present worth of all the remaining yearly fixed minimum payments up to the expiration of the patent on March 21, 1978, plus the already past due fixed minimum payments, for an approximate total sum of \$31,643.84.
- C. That WALLACE CLARK be required to account to ACHESON as to the quantities of coating compositions manufactured, used or sold by it, under said Agreement and to provide all such information as is needed to compute the exact amount of running royalties past due and owing together with interest under said Agreement.

- D. That WALLACE CLARK be adjudged liable to
ACHESON for adequate compensatory damages.
- E. That WALLACE CLARK be adjudged liable to
ACHESON for all ACHESON's costs, attorneys
fees, and disbursements of this action.
- F. That such other relief be awarded to Plaintiff as
is equitable and just.

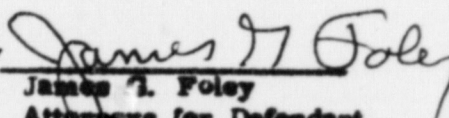
Respectfully submitted,

PENNIE & EDMONDS

Of Counsel for Defendant:

Michael R. Dinnin
HARNESSE, DICKEY & PIERCE
1500 North Woodward Avenue
Birmingham, Michigan 48011
(313) 642-7000

By


James T. Foley
Attorneys for Defendant
Acheson Industries, Inc.
330 Madison Avenue
New York, New York 10017
(212) 986-8600

WALLACE CLARK & COMPANY, INC., :
 :
 Plaintiff, :
 :
 v. : Civil Action No.
 : 74 CIV. 2812 EW
 ACHESON INDUSTRIES, INC., :
 :
 Defendant. :

1. Paragraph 22 of the Counterclaim is admitted.
2. Paragraph 23 of the Counterclaim is admitted.
3. Paragraph 24 of the Counterclaim is admitted.
4. Paragraph 25 of the Counterclaim is denied.
5. Paragraph 26 of the Counterclaim is denied, except that plaintiff admits it did sell Meta Tef 530 as a licensed product and has paid royalties therefor.
6. Paragraph 27 of the Counterclaim is denied.
7. Paragraph 28 of the Counterclaim is denied, but plaintiff admits it did sell Meta Tef 530 as a licensed product and has paid royalties therefor.
8. Paragraph 29 of the Counterclaim is denied.
9. In response to paragraph 30 of the Counterclaim, plaintiff realleges paragraphs 1 through 8 herein.
10. Paragraph 31 of the Counterclaim is denied.

11. Plaintiff alleges that the patent in suit is invalid for reasons set forth in paragraphs 10, 11, 14 and 21 of the Complaint.

12. Plaintiff alleges that the patent in suit has not been infringed as set forth in paragraphs 12, 13, 14, 15 and 16 of the Complaint.

AS A SECOND AFFIRMATIVE DEFENSE:

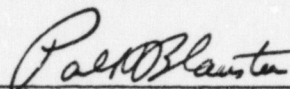
13. Plaintiff alleges that the products which it has sold are not within the valid scope of the patent claims in suit and are outside the scope of the License Agreement and that all royalties due have been paid.

AS A FOURTH AFFIRMATIVE DEFENSE:

14. Plaintiff alleges that under the doctrine of Lear v. Adkins that it has a right to challenge the validity of the patent in suit, notwithstanding the said License Agreement or said Consent Decree, as set forth in pars. 10 through 16 of the Complaint.

15. Plaintiff alleges that the patent in suit has been misused for reasons set forth in pars. 17 through 20 of the Complaint.

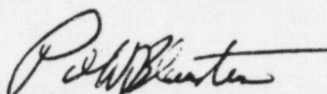
WHEREFORE, plaintiff requests that the Counterclaims be dismissed and that defendant be liable for all of plaintiff's costs, attorney fees, and disbursements in this action.


 Paul H. Blaustein
 Attorney for Plaintiff
 Hopgood, Calimafde, Kalil,
 Blaustein & Lieberman
 60 East 42nd Street
 New York, New York 10017

Dated: February 12, 1975
 New York, New York

CERTIFICATE OF SERVICE

I, Paul H. Blaustein, certify that a true and correct copy of the foregoing Plaintiff's Reply to Counterclaim has been mailed, postage prepaid, today, February 12, 1975, to James G. Foley, attorney for defendant, Pennie & Edmonds, 330 Maiden Avenue, New York, New York 10017.


 Paul H. Blaustein

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

-----x
WALLACE CLARK & COMPANY, INC., :

Plaintiff, :

v. :

Civil Action No.
74 CIV. 2812 EW

ACHESON INDUSTRIES, INC., :

Defendant. :

Notice of Cross Motions
and Motions

-----x
To: James G. Foley, Esq.
Pennie & Edmonds
330 Madison Avenue
New York, New York 10017

Attorney for Defendant

PLEASE TAKE NOTICE that on Tuesday, September 24, 1974
at the call of the Motion Calendar, at 10:00 a.m. or as soon
thereafter as counsel may be heard, at the United States
Courthouse, Foley Square, New York, the Undersigned will bring
on for hearing the Cross Motions for Orders (I) under
Rule 60(b)(5) and (6) FRCP for modification and clarification
of the Consent Decree (annexed as Exhibit B to Complaint); and
(II) for summary judgment as to the Second Cause of Action of
the Complaint. These Motions are supported by the annexed
Affidavit of Paul H. Blaustein, Esq., attorney for Plaintiff
Wallace Clark & Company, Inc., and Plaintiff's Reply Memorandum
In Opposition to Defendant's Motion to Stay Proceedings and In
Support of these Motions.

A34

Such papers are also submitted in opposition to
Defendant's Motion for Stay.

DATED: September 19, 1974

SANDOE, HOPGOOD & CALIMAFDE

By

Paul H. Blaustein
Paul H. Blaustein
Attorney for Plaintiff
60 East 42nd Street
New York, New York 10017
(212) 986-2480

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

-----x

WALLACE CLARK & COMPANY, INC.,	:	
Plaintiff,	:	
v.	:	Civil Action No.
ACHESON INDUSTRIES, INC.,	:	74 CIV. 2812 EW
Defendant.	:	

-----x

AFFIDAVIT

STATE OF NEW YORK)
) ss.:
COUNTY OF NEW YORK)

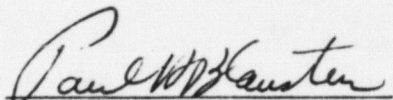
I, PAUL H. BLAUSTEIN, being duly sworn, depose and say:

1. I am the attorney for plaintiff in the above captioned action.
2. I wish to present the following documents to the Court in addition to Exhibits A, B and C which have been annexed to the Complaint, which may be deemed to be part of this Affidavit.
3. Said Exhibit A is the License Agreement between Acheson Industries, Inc. and Wallace Clark & Company, Inc., effective January 1, 1972; and Exhibit B being the Consent Decree in the Civil Action 71-5655. Exhibit C is the Complaint in the related case Acheson Industries, Inc. v. Wallace Clark & Company, Inc. in the Circuit Court for the County of Wayne, Michigan. Exhibit D herein is a copy of the marked Complaint in this action. Exhibit E is portions of the Motion to Stay Proceedings filed by Wallace Clark & Company, Inc. in the related case in the Circuit Court for the County of Wayne in the State of Michigan.

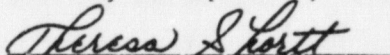
4. I further state from my information and knowledge that Wallace Clark & Company, Inc. makes, in addition to the Meta-Tef 530, which is the only item identified in the Consent Judgment, other compositions, namely Meta-Tef 730, Meta-Tef 530 Modified, Meta-Tef 600 and Meta-Tef 205, which in my opinion are not infringing. The technical aspects of patent validity and patent infringement are not presented to the Court in this Motion, but suffice it to say that plaintiff regards the Acheson Industries' patent as being extremely limited and likely to be held invalid. The issue presented involves the legal effect of the prior consent judgment.

5. Wallace Clark & Company, Inc. is a relatively small company having offices at Carlsbad, New Jersey, where its principal chemists work. Plaintiff Wallace Clark's total sales in the last preceeding year were less than \$2 million. Where on information and belief, the total sales of Acheson Industries were over \$30 million.

6. It is respectfully submitted that the Court which issued the consent judgment should determine its effect under the appropriate motion made under Rule 60(b)(5) and (6) FRCP, in light of Lear v. Adkins, 395 U.S. 653 (1969) and the law of the Second Circuit.


 Paul H. Blaustein
 Attorney for Plaintiff
 Sandoe, Hopgood & Calimafde
 60 East 42nd Street
 New York, New York 10017

Sworn to before me this
 19th day of September, 1974.


 Theresa Shortt
 Notary Public

Theresa Shortt
 Notary Public, State of New York
 No. 41-4514343
 Qualified in Queens County
 Certificate filed in New York County
 Commission Expires March 30, 1975

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

WALLACE CLARK & COMPANY, INC.,

Plaintiff,

v.

Civil Action No. 74 CIV. 2812 EW

ACHESON INDUSTRIES, INC.,

Defendant.

WITHDRAWAL BY DEFENDANT OF
ITS MOTION TO STAY PROCEEDINGS
HEREIN

Now comes the defendant, through its counsel, and withdraws its motion to stay the proceedings herein, or requests this Court to deny said motion without prejudice. The defendant's motion to stay the proceedings herein was argued before this Court on September 24, 1974, along with certain cross-motions made by plaintiff.

As reasons for withdrawing the motion to stay defendant states the following:

(1) An earlier consent decree (Exhibit B filed with the complaint herein) is involved in this litigation and said consent decree involved the same parties to the present civil action. Since this earlier consent decree was rendered by the United States District Court for the Southern District of New York, defendant therefore considers that this Court should decide the effect of the earlier consent decree.

(2) As this Court is aware there is related litigation between the same parties hereto, which related litigation is presently pending in a Michigan state court in Detroit (Civil Action No. 74-012-650-CK, Circuit Court for Wayne County, Detroit, Michigan). As in the present

action essentially no discovery has been initiated in the Michigan case other than fourteen interrogatories propounded to Wallace Clark which have already been answered. Due to the trial calendar in the Michigan state court that case will not be called for pretrial conference until at least the latter part of 1977; and, even after being called for pretrial conference in the Michigan state court there can be no trial date set therein until another six to eight months after the pretrial conference. This means that the Michigan state court action would not be set for trial until at least mid-1978 or later, whereas the patent in suit would be expired as of March 1978. The status of the Michigan state court's calendar has just recently been checked upon and confirmed by defendant Acheson's Michigan counsel, Mr. Dinnin.

Accordingly, in view of the above defendant withdraws its motion to stay the proceedings herein or requests that said motion be denied without prejudice. On the basis of Broadview Chemical Corp. v. Loctite Corp., 474 F. 2d 1391 (2nd Cir., 1973) and for the other reasons advanced by the defendant at the hearing on September 24, 1974, including the points and authorities defendant has already cited to the Court herein] we again submit that plaintiff's motion under Federal Civil Procedure Rule 60 and plaintiff's motion for summary judgment as to its second cause of action should both be denied.

Respectfully submitted,

PENNIE & EDMONDS

Date: Dec 16, 1974

Of Counsel for Defendant:

Michael R. Dinnin
HARNESS, DICKEY & PIERCE
1500 North Woodward Avenue
Birmingham, Michigan 48011
(313) 842-7000

By James G. Foley
James G. Foley
Attorneys for Defendant
Acheson Industries, Inc.
330 Madison Avenue
New York, New York 10017
(212) 986-8686

**WALLACE CLARK & COMPANY,
INC., Plaintiff,**

v.

**ACHESON INDUSTRIES, INC.,
Defendant.**

No. 74 Civ. 2812.

United States District Court,
S. D. New York.

April 28, 1975.

Patent licensee brought action seeking declaration of invalidity of defendant's patent and its noninfringement by plaintiff's product. Plaintiff moved to be relieved from terms of consent decree which was entered in similar prior action. The District Court, Edward Weinfeld, J., held that rule providing for relief from a judgment on ground that it is no longer equitable and that the judgment should have prospective application contemplates relief from a judgment as a result of a later change in the law and does not apply where case relied upon as a precedent by the court in rendering the present judgment has since been reversed, that general rule is that a consent judgment has res judicata effect, that consent decrees containing adjudication of patent validity and infringement, entered into without collusion, after litigants had had the opportunity for pretrial discovery and trial on the merits is to be accorded res judicata effect and that since prior decree was entered into without collusion and following pretrial discovery was entitled to res judicata effect with respect to patent validity and infringement by plaintiff's product which was at issue in the prior suit but that plaintiff could assert noninfringement by other products which were not the subject of the prior consent decree.

Motion denied.

1. Judgment ¶651

As included in consent decrees in patent litigation, recital that decree may not be cited as an adjudication of con-

tested issues nor be used for advertising purposes was not intended to deprive consent decrees of their res judicata effect; such clause was designed to prevent misuse of consent decrees with respect to third parties by representations, whether explicit or implicit, that the judgment was entered after a trial on the merits.

2. Federal Civil Procedure ¶2651

Rule contemplating relief from a judgment on ground that it is no longer equitable that the judgment should have prospective application contemplates relief from a judgment as result of a later change in the law such as when a statute is amended or when a prior judgment is reversed or modified. Fed. Rules Civ. Proc. rule 60(b)(5), 28 U.S.C.A.

3. Federal Civil Procedure ¶2651

Relief from a judgment on ground that it is no longer equitable that the judgment should have prospective application because of reversal of a prior judgment is restricted to situations where the present judgment is based on the prior judgment in the sense of res judicata or collateral estoppel. Fed. Rules Civ. Proc. rule 60(b)(5), 28 U.S.C.A.

4. Federal Civil Procedure ¶2651

Rule providing for relief from a judgment on ground that it is no longer equitable that the judgment should have prospective application does not apply where case relied on as a precedent by the court in rendering the present judgment has since been reversed. Fed. Rules Civ. Proc. rule 60(b)(5), 28 U.S.C.A.

5. Judgment ¶651

General rule is that a consent judgment has res judicata effect.

6. Judgment ¶644

The public interest is dominant in the patent system; consequently, to protect the public interest in the free circulation of ideas, the doctrine of res judicata in patent cases has been limited so as to assure that invalid patents are not

used or valid patents misused to acquire a monopoly power.

7. Declaratory Judgment \Rightarrow 232

Although to hold a patent valid if it is not infringed is to decide a hypothetical case, invalidity will be adjudicated in absence of infringement since an invalid patent should not remain in the art as a scarecrow.

8. Judgment \Rightarrow 651

Balancing of relevant public interest factors requires that consent decrees containing adjudications of patent validity and infringement, entered into without collusion, after the litigants have had the opportunity for pretrial discovery and a trial on the merits, are to be given res judicata effect such decrees should be of no less binding force than a judgment of validity and infringement entered after a trial on the merits.

9. Monopolies \Rightarrow 12(1)

Public policy against monopolies is not without its limits.

10. Federal Civil Procedure \Rightarrow 1711

In granting a voluntary dismissal the court may impose terms as a condition thereof to prevent abuse of the judicial process. Fed.Rules Civ.Proc. rule 41(a), 28 U.S.C.A.

11. Declaratory Judgment \Rightarrow 63

Giving the stamp of approval to a meaningless document can only breed disrespect for the sanctity of a judicial decree.

12. Judgment \Rightarrow 651

Where consent decree, in which patent was held both valid and infringed, was entered into without collusion and after pretrial discovery, decree was to be accorded res judicata effect in subsequent suit by the same plaintiff seeking declaration of validity and noninfringement; however, prior decree did not foreclose plaintiff from asserting noninfringement as to products which were not the subject of the prior decree.

Sandoe, Hopgood & Calimafde, New York City, for plaintiff; Paul H. Blau-stein, New York City, of counsel.

Pennie & Edmonds, New York City, for defendant; James G. Foley, New York City, Harness, Dickey & Pierce, Michael Dinnin, Jr., Birmingham, Mich., of counsel.

OPINION

EDWARD WEINFELD, District Judge.

This is the second action instituted in this court by plaintiff, Wallace Clark & Company, Inc. ("Wallace Clark"), against the defendant, Acheson Industries, Inc. ("Acheson"), involving the validity and infringement of patent No. 2,976,257 issued to and owned by Acheson. The first action was instituted by plaintiff in December 1971 for a declaratory judgment of invalidity of defendant's patent and its non-infringement by plaintiff's manufacture, use and sale of its product Meta-Tef 530. Acheson counterclaimed, charging plaintiff with patent infringement. After pretrial discovery procedures the case moved forward to trial; however, it was never tried. The parties entered into a consent decree wherein Acheson's patent was held both valid and infringed by plaintiff's product Meta-Tef 530. Coincidental thereto, the parties executed a non-exclusive licensing agreement under which Wallace Clark is licensed to manufacture and sell certain products under the claims of Acheson's patent with royalty payments determined on a percentage basis with a fixed minimum. The license is coterminous with the patent; both expire on March 21, 1978. Pursuant to the agreement, the consent decree was submitted to and duly signed on October 6, 1972 by Judge Cannella, to whom the matter had been assigned. The decree provided for the dismissal of the action with each party to bear its own costs and attorneys' fees.

[1] Plaintiff made the payments required under the license agreement until

January 1, 1974, when it discontinued making further payments. Thereupon, in April 1974, Acheson filed an action in Michigan state court against Wallace Clark for breach of the licensing agreement. Wallace Clark counterclaimed for a declaratory judgment that it had the right to contest validity of the Acheson patent and also to allege invalidity and non-infringement as a defense to Acheson's suit to recover royalty payments; it also asserted as a defense patent misuse, claiming that the minimum royalty clause is an illegal extension of the patent. In addition, Wallace Clark counterclaimed for treble damages under section 1 of the Sherman Act¹ based upon the provision in the license agreement that it may not be terminated during the life of the patent. Within two months thereafter, in June 1974, Wallace Clark instituted this action, the second in this court, for a declaratory judgment asserting substantially the same claims advanced as defenses and counterclaims in the Michigan action.²

[2-4] Wallace Clark now moves to be relieved of the terms of the consent decree under Rule 60(b)(5) of the Federal Rules of Civil Procedure on the ground that "it is no longer equitable that the judgment should have prospective application," and under Rule 60(b)(6) for "other reason[s] justifying relief from the operation of the judgment." While it seeks relief under the foregoing rule, actually its motion is for summary judgment to determine the res judicata effect of the consent decree considered in light of the Supreme Court's ruling in *Lear, Inc. v. Adkins*.³ Wallace Clark's request for relief is mis-cast under Rule 60(b)(5) or (6) since it entered into the consent decree three years after the Supreme Court's decision in *Lear* on June 16, 1969. Presumably the parties to the lawsuit, represented by the same experienced patent attorneys who now appear on their behalf, were not unfamiliar with its holding.⁴ Acheson agrees the issue is one of law and that the matter is ripe for disposition. Accordingly, we turn to the mer-

1. 15 U.S.C. § 1.

2. Acheson moved to stay this action pending determination of its suit in the Michigan state court. Wallace Clark moved to stay the Michigan state court action pending a determination of this action. While the instant motion was sub judice, the Michigan state court rendered a decision upholding Wallace Clark's position that the consent decree is not entitled to res judicata effect, but it did so because of paragraph 3 of the decree referred to below. Leave to appeal was granted. Notwithstanding the ruling in that case, both parties stipulated to dismiss the Michigan action and to proceed in this court for determination of the issue.

The provision of paragraph 2 of the consent decree that "[t]his decree may not be cited as an adjudication of contested issues, nor be used for advertising purposes," is regularly included in patent consent decrees in this district, and this court has always required its inclusion. The provision was never intended to deprive consent decrees of their res judicata effect and plaintiff makes no such claim in this court. The clause was designed to prevent misuse of consent decrees with respect to third parties by representations, whether explicit or implicit, that

the judgment was entered after a trial on the merits. See *PCR Golf Ball Co. v. Chemold Corp.*, 361 F.Supp. 187 (E.D.N.Y. 1973). The same precautionary provision is included in copyright cases.

3. 395 U.S. 653, 80 S.Ct. 1902, 23 L.Ed.2d 610 (1969).

4. Rule 60(b)(5) contemplates relief from a judgment as a result of a later change in the law such as when a statute is amended or when a prior judgment is reversed or modified. See, e.g., *Class v. Norton*, 507 F.2d 1058, 1061-62 (2d Cir. 1974). Moreover, relief from a judgment on the latter grounds is restricted to situations where the present judgment is based on the prior judgment in the sense of res judicata or collateral estoppel. Rule 60(b)(5) does not apply where a case relied on as precedent by the court in rendering the present judgment has since been reversed. *Title v. United States*, 263 F.2d 28, 31 (9th Cir.), cert. denied, 359 U.S. 989, 79 S.Ct. 1118, 3 L.Ed.2d 978 (1959); *Berryhill v. United States*, 199 F.2d 217, 219 (6th Cir. 1952); *Loucke v. United States*, 21 F.R.D. 305 (S.D.N.Y. 1957). See 11 C. Wright & A. Miller, *Federal Practice and Procedure* § 2863 (1973).

its of plaintiff's claim for relief under the summary judgment rule.⁵

I

A.

[5] Plaintiff, in reliance upon *Lear*, seeks to avoid any res judicata effect of the consent decree. Under the general rule that a consent judgment has res judicata effect,⁶ plaintiff would be estopped from contesting the validity of Acheson's patent and that its Meta-Tef 530 product infringes thereon. However, Wallace Clark contends that the decree should not be accorded res judicata effect in light of the public policy against invalid patent monopolies. Thus, the issue to be determined is the res judicata effect of the consent decree in subsequent litigation between the same parties presenting the same issues of validity and infringement as in the prior action.

B.

Since plaintiff's principal reliance in support of its position is on *Lear*, it is desirable to consider the facts upon which *Lear* was grounded, its precise holding and its underlying rationale.

Adkins, an inventor, was hired by Lear, Inc. in January 1952 to help solve gyroscope problems encountered by Lear in its work in the aviation field. They entered into a preliminary agreement which provided that all new ideas, discoveries and inventions related to vertical gyros became the property of Adkins; in turn, he agreed to grant Lear a license as to all ideas he developed on a mutually satisfactory royalty basis. Adkins soon developed an improved gy-

roscope which Lear incorporated into its production process. In February 1954, Adkins filed an application with the Patent Office to protect his improvements, and at about the same time entered into negotiations with Lear for licensing and royalty arrangements. These negotiations were concluded in September 1955 in an agreement which defined the conditions under which Lear's California gyros used his patent and that in licensing that both the Michigan and was obligated to pay royalties for Adkins' improvements. This agreement provided that if the Patent Office refused to grant a patent on Adkins' pending application, or if a patent were issued and later declared invalid, Lear had the option to terminate the specific license so affected or to terminate the entire agreement.

Adkins' patent application was not granted until 1960, only after he had narrowed the scope of his claims following rejection of his original broad claim that his entire method of constructing gyroscopes was entitled to a patent monopoly. From the filing by Adkins of his original application in 1954 to the grant of his patent in 1960, Lear questioned that Adkins was entitled to receive a patent. In 1957, after Adkins' patent applications had been rejected twice, Lear contended that a Patent Office search disclosed a prior patent which had fully antedated Adkins' discovery. Lear then refused to pay royalties any longer on gyroscopes produced at its Michigan plant, which it claimed it had developed independently, although it continued to pay royalties on those produced at its California plant until 1959.

5. Fed.R.Civ.P. 56.

6. *United States v. Southern Ute Indians*, 402 U.S. 159, 91 S.Ct. 1336, 28 L.Ed.2d 695 (1971); *Siegel v. National Periodical Publications*, 508 F.2d 909, 913 (2d Cir. 1974); *Siebring v. Hansen*, 346 F.2d 474, 477 (8th Cir.), cert. denied, 382 U.S. 943, 86 S.Ct. 400, 15 L.Ed.2d 352 (1965); *Kiwi Coders Corp. v. Arco Tool & Die Works*, 250 F.2d 562, 568 (7th Cir. 1957); *Folgueras v. Ilas-*

le, 331 F.Supp. 615, 616 (W.D.Mich.1971); *Stuyvesant Ins. Co. v. Dean Const. Co.*, 254 F.Supp. 102, 110 (S.D.N.Y.1966), *aff'd sub nom. Stuyvesant Co. v. Kelly*, 382 F.2d 911 (2d Cir. 1967); *Moore's Federal Practice* ¶ 0.400[5]. See *United States v. Swift & Co.*, 286 U.S. 106, 115, 52 S.Ct. 460, 462, 76 L.Ed. 909 (1932): "We reject the argument . . . that a decree entered upon consent is to be treated as a contract and not as a judicial act."

Cite as 394 F.Supp. 393 (1975)

When Adkins obtained his patent in 1960, he brought suit against Lear. Lear's failure to pay royalties on those gyros was a breach both of the 1955 contract and Lear's quasi-contractual obligation. Lear sought to raise patent invalidity as a defense, but the trial judge directed a verdict in favor of Adkins on the California gyros, holding that Lear was estopped by the licensing agreement from questioning Adkins' patent. Following an intermediate appeal, the case reached the California Supreme Court, which held that

"[o]ne of the oldest doctrines in the field of patent law establishes that so long as a licensee is operating under a license agreement he is estopped to deny the validity of his licensor's patent in a suit for royalties under the agreement. The theory underlying this doctrine is that a licensee should not be permitted to enjoy the benefit afforded by the agreement while simultaneously urging that the patent which forms the basis of the agreement is void."⁷

The court found that the 1955 agreement between Adkins and Lear was in effect and concluded that under the doctrine of licensee estoppel, Lear was barred from challenging the validity of Adkins' patent.

The Supreme Court recognized that when it last considered the doctrine in *Automatic Radio Manufacturing Co. v. Hazeltine Research, Inc.*,⁸ it, like the California Supreme Court, had invoked estoppel to deny a licensee the right to prove that his licensor was demanding royalties for the use of an idea which was not validly patented and thus a part of the public domain. Certiorari was granted "to reconsider the validity of

the Hazeltine rule in the light of . . . recent decisions emphasizing the strong federal policy favoring free competition in ideas which do not merit patent protection."⁹

In considering this issue, Mr. Justice Harlan reviewed in detail the Supreme Court, intermediate federal and state court cases which had carved out various exceptions to the "general rule" of licensee estoppel, and observed that the exceptions had all but eroded the estoppel doctrine in patent licensing agreements. Thus, he concluded:

"The uncertain status of licensee estoppel in the case law is a product of judicial efforts to accommodate the competing demands of the common law of contracts and the federal law of patents. On the one hand, the law of contracts forbids a purchaser to repudiate his promises . . . because he later becomes dissatisfied with the bargain he has made. . . . On the other hand, federal law requires that all ideas in general circulation be dedicated to the common good unless they are protected by a valid patent. [citations omitted] When faced with this basic conflict in policy, both this Court and courts throughout the land have naturally sought to develop an intermediate position which somehow would remain responsive to the radically different concerns of the two different worlds of contract and patent. The result has been a failure. Rather than creative compromise, there has been a chaos of conflicting case law, proceeding on inconsistent premises."¹⁰

He thereupon "renew[ed] the search for an acceptable middle ground."¹¹

7. *Adkins v. Lear, Inc.*, 67 Cal.2d 882, 891, 64 Cal.Rptr. 545, 549, 435 P.2d 321, 325-26 (1967).

8. 339 U.S. 827, 836, 70 S.Ct. 894, 94 L.Ed. 1312 (1950).

9. 395 U.S. at 656, 89 S.Ct. at 1904, citing *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.

S. 225, 84 S.Ct. 784, 11 L.Ed.2d 661 (1964); *Comco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 84 S.Ct. 779, 11 L.Ed.2d 669 (1964).

10. 395 U.S. at 668, 89 S.Ct. at 1910.

11. *Id.*

In searching for this accommodation, the Court reasoned that a patent is a legal conclusion reached by the Patent Office about which reasonable men could differ widely, a conclusion often reached in an *ex parte* proceeding. In this circumstance the Court considered it not unfair to require a patentee to defend the Patent Office's judgment when his licensee raises the issue of validity, particularly since the licensor has the benefit of the presumption of validity which attaches to his patent.¹² Licensees are usually the only individuals possessed with sufficient economic incentive to challenge the patentability of an inventor's discovery, and "[i]f they are muzzled, the public may continually be required to pay tribute to would-be monopolists without need or justification."¹³ In ultimate terms the Court concluded that "the important public interest in permitting full and free competition in the use of ideas which are in reality a part of the public domain" required that "the technical requirements of contract doctrine must give way before the demands of the public interest."¹⁴ Accordingly, the general licensee estoppel doctrine enunciated in *Automatic Radio Manufacturing Co. v. Hazeltine Research Inc.* was overruled and put to rest.¹⁵

C.

This extended recital points up at once essential differences between the facts in *Lear* and those in the instant case. *Lear*, from the time it acquired its licensing rights prior to grant of the patent, had challenged Adkins' right to

the patent monopoly. And after the grant of the patent, *Lear* was never permitted by the California courts to challenge the validity of the patent because of the doctrine of licensee estoppel. In *Lear* there was no litigation leading to a consent decree. Here a consent decree and license agreement were entered into only after the issuance of the patent and after Wallace Clark commenced its first declaratory judgment action. This was after pretrial discovery and with a full opportunity to have the contested issues of validity and infringement judicially determined.¹⁶

Wallace Clark's present attempt to disavow its commitment under the decree rests upon the rationale that if it, as a licensee, is now foreclosed from challenging the validity of the patent, the public would be forced to pay tribute to an unwarranted monopoly grant. Accordingly, plaintiff presses that the public interest as explicated in *Lear* is predominant that its own prior conduct in voluntarily entering into the consent decree is irrelevant and that it should not be estopped from challenging the validity of plaintiff's patent—in short, that the "public interest in a judicial determination of the invalidity of a worthless patent"¹⁷ not only outweighs principles of contract law, but also the public policy favoring the finality of litigation and the conservation of judicial resources. It may be in order to observe, however, as Judge Friendly did in another context, that public policy "is a very unruly horse, and when once you get astride it, you never know where it will carry you."¹⁸

12. 35 U.S.C. § 282.

13. 395 U.S. at 670, 89 S.Ct. at 911.

14. *Id.*

15. *Id.* at 671, 89 S.Ct. at 911.

16. "Consent decrees are entered into by parties to a case after careful negotiation has produced agreement on their precise terms. The parties waive their right to litigate the issues involved in the case and thus save themselves the time, expense, and inevitable risk of litigation. Naturally, the agreement

reached normally embodies a compromise; in exchange for the saving of cost and elimination of risk, the parties each give up something they might have won had they proceeded with the litigation." *United States v. Armour & Co.*, 402 U.S. 673, 681, 91 S.Ct. 1752, 1757, 29 L.Ed.2d 256 (1971).

17. *Addressograph-Multigraph Corp. v. Cooper*, 156 F.2d 483, 485 (2d Cir. 1946).

18. *Painton & Co. v. Bouras, Inc.*, 442 F.2d 216, 225 (2d Cir. 1971), quoting *Richardson v. Mellish*, 2 Bing. 229, 252 (1824).

Cite as 394 F.Supp. 393 (1975)

[6, 7] We start with the observation that the public interest is dominant in the patent system; consequently, to protect the public interest in the free circulation of ideas, the doctrine of res judicata in patent cases has been limited to assure that invalid patents are not used or valid patents misused to acquire a monopoly power.¹⁹ Thus, long before *Lear*, this circuit held in *Addressograph-Multigraph Corp. v. Cooper*²⁰ that a consent decree in a prior suit by the same parties which merely decreed that a patent was valid did not estop a party from later contesting validity in another suit for infringement brought by the same plaintiff. But where there was an adjudication of infringement, the decree would be given res judicata effect. The holding in *Addressograph* was based

"on grounds of public policy . . . that in a decree, at least in one entered in by consent, either an adjudication of infringement, or a grant of some relief from which infringement may be inferred, is essential before any effect of res judicata can be given to it on the issue of validity."²¹

Since *Lear*, several courts have recognized that a consent decree adjudicating patent validity alone is not res judicata.²² There are substantial reasons for refusing to grant such decrees res judicata

effect. An invalid patent cannot be infringed; conversely, only a valid patent can be infringed. In the words of the Supreme Court: "To hold a patent valid if it is not infringed is to decide a hypothetical case."²³ When sued by the owner of a patent, a defendant's principal concern is to resist a finding of infringement; that a patent is declared valid is of little consequence to him as against his interest in warding off a finding of infringement which may cast him in substantial liability. This was the underlying rationale of our Court of Appeals in *Addressograph* in concluding that a consent decree which merely declared validity was not entitled to estoppel force, whereas one that also included an adjudication of infringement would be given res judicata effect on the validity issue.²⁴

Plaintiff urges that despite the adjudication of infringement in the consent decree entered in the prior action, *Lear*'s public interest concept requires that its doctrine be extended to apply to such decrees—in effect that *Addressograph* is no longer good law. Two Courts of Appeals have considered this issue, but neither made a definitive ruling. Our own Court of Appeals, invited to overrule *Addressograph*, declined to do so since plaintiff sought no declaration of inva-

19. *Mercoird Corp. v. Mid-Continent Co.*, 320 U.S. 661, 665-66, 64 S.Ct. 268, 68 L.Ed. 376 (1944).

20. 156 F.2d 483 (2d Cir. 1946).

21. *Id.*, at 485.

22. *Crane v. Aeroquip Corp.*, 504 F.2d 1086, 1092 (7th Cir. 1974); *Kraly v. National Distillers and Chem. Corp.*, 502 F.2d 1366, 1368 (7th Cir. 1974); *Broadview Chem. Corp. v. Loctite Corp.*, 474 F.2d 1391, 1395 (2d Cir. 1973); *Business Forms Finishing Service, Inc. v. Carson*, 452 F.2d 70, 75 (7th Cir. 1971). *Contra*, *Schlegel Mfg. Co. v. King Aluminum Corp.*, 369 F.Supp. 650 (S.D. Ohio 1973). *Cf.* *Massillon-Cleveland-Akron Sign Co. v. Golden State Adv't Co.*, 444 F.2d 425 (9th Cir.), cert. denied, 402 U.S. 873, 92 S.Ct. 100, 30 L.Ed.2d 117 (1971) (covenant in settlement agreement not to contest patent's validity void and unenforceable as against public policy.)

23. *Altwater v. Fresmann*, 319 U.S. 359, 363, 63 S.Ct. 1115, 1117, 87 L.Ed. 1450 (1943). As a matter of logic, as a number of courts have observed, it should follow that "to hold a patent invalid if not infringed is also to decide a hypothetical case." *Addressograph-Multigraph Corp. v. Cooper*, 156 F.2d 483, 485 (2d Cir. 1946); *Hale v. General Motors Corp.*, 147 F.2d 383, 388 (1st Cir. 1945). Even so, invalidity has been adjudicated in the absence of infringement because, in the apt words of Chief Judge Learned Hand, the invalid patent "should not remain in the art as a scarecrow." *Bresnick v. United States Vitamin Corp.*, 139 F.2d 239, 242 (2d Cir. 1943); see also *Cover v. Schwartz*, 133 F.2d 541, 545 (2d Cir. 1942), cert. denied, 319 U.S. 748, 63 S.Ct. 1158, 87 L.Ed. 1703 (1943).

24. *Addressograph-Multigraph Corp. v. Cooper*, 156 F.2d 483, 484-85 (2d Cir. 1946).

lidity and defendant made no charge of infringement. The court stated: "In light of the record before us which fails to establish any pleading or proof of invalidity, we see no warrant here to extend *Lear* or to overrule *Adressograph*."²⁵ The Seventh Circuit Court of Appeals, in dictum, seemingly favors extending *Lear* to apply to all consent decrees. In *Kraly v. National Distillers and Chemical Corporation*,²⁶ where an infringement action was dismissed with prejudice but there was no adjudication of infringement, the court hypothesized as follows:

"Even if we assume, however, that the consent decree embodied an adjudication of infringement, we do not believe that the *Lear* rationale would necessarily be inapplicable."²⁷

With due deference to the *Kraly* court,²⁸ such a holding is undesirable.

It is important to emphasize the precise thrust of *Lear*. It abolished the doctrine of estoppel to permit a licensee to challenge the validity of the patent in a suit for royalties due under the contract, recognizing that usually licensees are the only parties with enough economic incentive to do so. The position here urged by plaintiff is not needed to enable a licensee to attack a patent's validity. It is one thing to say that a party is not prevented from contesting the validity of a patent merely by entering into a licensing agreement. It is quite another to allow one, freed of the barrier of licensee estoppel, to commence litigation with a full opportunity for a trial on the issues of validity and infringement, to consent to an adverse adjudica-

tion on both issues and then for him cavalierly to ignore the consequences of the decree based on such consent the minute he leaves the courthouse. The decree under that theory is merely a scrap of paper.

[8] In this court's view, a balancing of the relevant public interest factors requires that consent decrees containing adjudications of validity and infringement, entered into without collusion, after the litigants have had the opportunity for pretrial discovery and a trial on the merits, be accorded *res judicata* effect. Such decrees should be of no less binding force than a judgment of validity and infringement entered after a trial on the merits. To hold otherwise would permit abuse of the judicial process, waste of judicial resources and reward questionable ethical conduct. These are all matters which also concern the public interest. To adopt the plaintiff's position would force every patent validity and infringement suit to a trial on the merits to assure a *res judicata* effect. It would discourage settlement of such litigation, since otherwise there could be no assurance of finality. Must this assurance come only as a result of a trial on the merits so that litigation is compelled to achieve an unassailable position? The public interest is not served by driving a patentee and an alleged infringer into extended litigation of a kind recognized by the Supreme Court as "a very costly process," entailing "staggering" financial burdens upon the respective litigants where, even in a nonjury trial, "an inordinate amount of trial time"²⁹ is required.

25. *Broadview Chem. Corp. v. Loctite Corp.*, 474 F.2d 1391, 1395 (2d Cir. 1973).

26. 502 F.2d 1366 (7th Cir. 1974).

27. *Id.* at 1369.

28. Relying on the *Kraly* decision, the court in *USM Corp. v. Standard Pressed Steel Co.*, 184 U.S.P.Q. 476 (N.D.Ill.1974) held that a consent decree finding patent validity and infringement would not be given *res judicata* effect.

29. *Blonder-Tongue v. University Foundation*, 402 U.S. 313, 334, 337, 91 S.Ct. 1434, 1447, 28 L.Ed.2d 788 (1971). See *Commissioner of Internal Revenue v. Sweeney*, 333 U.S. 591, 597, 68 S.Ct. 715, 719, 92 L.Ed. 898 (1948):

"The general rule of *res judicata* applies to repetitious suits involving the same cause of action. It rests upon considerations of economy of judicial time and public policy favoring the establishment of certainty in legal relations."

Cite as 394 F.Supp. 393 (1975)

To plaintiff's contention that it should again be permitted to challenge the validity of the patent in the public interest, the short answer is that it had that opportunity in its first declaratory judgment action wherein it consented to the decree it now seeks to void. Either it then failed to serve the public interest when it abandoned its attack on the validity of the patent or, perhaps satisfied it was valid, served its own economic interest. Having derived the benefits of a settlement and a license agreement, plaintiff should not now, upon a claim that it is the defender of the public interest, be permitted to disavow its commitments.

[9] The public policy against monopolies is not without its limits, as two Seventh Circuit cases demonstrate. In *Ransburg Electro-Coating Corp. v. Spiller and Spiller, Inc.*,³⁰ the court enforced a settlement agreement to pay money for past infringement even though after the settlement agreement was entered into, a different Court of Appeals held that the subject of the settlement did not infringe. The court recognized that enforcement of the settlement contract would result in the payment of damages partly for the use of a device that is outside the scope of the patent. While *Lear* concluded that federal patent policy requires the abolition of the doctrine of licensee estoppel, the court held "that such policy must occupy a subsidiary position to the fundamental policy favoring the expedient and orderly settlement of disputes and the fostering of judicial

economy."³¹ Similarly, in *Maxon Premix Burner Co. v. Eclipse Fuel Eng. Co.*,³² the court noted that while public policy encourages tests of patent validity, public policy also favors conservation of judicial time and limitations on expensive litigation.³³ Therefore, the court held that a party had waived the right to contest the validity of a patent by raising the issue for the first time in post trial motions after the court had found infringement.

The Ninth Circuit, in *Schnitger v. Canoga Electronics Corp.*,³⁴ held that a trial on the merits is not required before a judgment of patent validity and infringement is entitled to res judicata effect. The court's per curiam decision does not so indicate, but an examination by this court of the record in *Schnitger* reveals that the prior judgment accorded res judicata effect was obtained by default. The holding in the instant case follows a fortiori.³⁵

[10] To permit plaintiff to reassert in this suit the same claims it advanced in its first action is tantamount to relegating all consent decrees in patent suits of this kind to the status of a voluntary dismissal without prejudice under Rule 41(a) of the Federal Rules of Civil Procedure, with the end result as if the action had not been brought in the first place.³⁶ At least in the instance of a voluntary dismissal the court may impose terms as a condition thereof to prevent abuse of the judicial process.³⁷ Under plaintiff's theory, it could immediately upon the entry of the consent decree commence a second litigation, free

30. 480 F.2d 974 (7th Cir. 1973).

31. 480 F.2d at 978.

32. 471 F.2d 308 (7th Cir. 1972), cert. denied, 410 U.S. 929, 93 S.Ct. 1365, 35 L.Ed.2d 591 (1973).

33. 471 F.2d at 312.

34. 462 F.2d 628 (9th Cir. 1972).

35. Record on Appeal at 18.

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36. *Humphreys v. United States*, 272 F.2d 411, 412 (9th Cir. 1949); *A. B. Dick Co. v. Marr*, 197 F.2d 498, 502 (2d Cir.), cert. denied, 344 U.S. 878, 73 S.Ct. 169, 97 L.Ed. 680 (1952); 9 C. Wright & A. Miller, *Federal Practice and Procedure* § 2367 (1971).

37. *Harvey Aluminum, Inc. v. American Cyanamid Co.*, 15 F.R.D. 14, 18 (S.D.N.Y. 1953).

of any conditions or costs and engage the time and attention of heavily overburdened court.

If consent decrees of validity and infringement could so readily be disregarded by an alleged infringer, there is less incentive on his part to challenge the patent when the issue of infringement first arises in a litigation--the logical time to do so if the public interest is to be promptly served. Adopting the plaintiff's position may postpone the time when invalid patents are successfully challenged, to the detriment of the public interest.³⁸

[11] Finally, if consent decrees entered into by litigants free from collusion do not have res judicata effect, then courts are called upon to perform an idle ceremony. Giving the stamp of approval to a meaningless document can only breed disrespect for the sanctity of a judicial decree. If that is the end result, such decrees should not be signed by the courts.

[12] Accordingly, the consent decree entered in the prior action between the parties is to be accorded res judicata effect with respect to the adjudication of (1) the validity of the patent, and (2) infringement of the patent by plaintiff's product Meta-Tef 530.

II

As to plaintiff's further motion for summary judgment under its second cause of action, the foregoing disposition does not foreclose plaintiff from asserting non-infringement of defendant's patent by other products manufactured by it, which products were not the subject of the prior consent decree. Since there are disputed issues, the motion is denied.

38. *Ransburg Electro-Coating Corp. v. Spiller and Spiller, Inc.*, 489 F.2d 974, 978 (7th Cir. 1973).

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

-----X

WALLACE CLARK & CO., INC.,	:	
Plaintiff,	:	
v.	:	Civil Action No.
ACHESON INDUSTRIES, INC.	:	74 Civ. 2812 EW
Defendant	:	

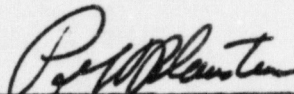
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TO: JAMES G. FOLEY, ESQ.
Pennie & Edmonds
330 Madison Avenue
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Attorneys for Defendant

Now comes plaintiff and gives notice that on Tuesday, May 27, 1975, at the call of the motion calendar, at p.m., or as soon thereafter as counsel may be heard, in Room 706, United States Courthouse, Foley Square, New York, New York, the plaintiff will bring on for hearing the Plaintiff's Motion for (I) Reconsideration and Clarification of this Court's Opinion of April 28, 1975; (II) Summary Judgment on the Ground of Misuse; and (III) Leave to Appeal to the Court of Appeals under 28 U.S.C. § 1292(b).

Answering papers are demanded five days before the return date.

Respectfully submitted,


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Attorneys for Plaintiff

Dated: New York, New York
May 8, 1975

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

-----X

WALLACE CLARK & COMPANY, INC.,	:	
Plaintiff,	:	
v.	:	Civil Action No.
ACHESON INDUSTRIES, INC.,	:	74 Civ. 2812 EW
Defendant.	:	

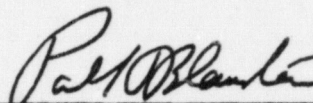
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PLAINTIFF'S MOTION FOR:

- (I) RECONSIDERATION AND CLARIFICATION OF THIS COURT'S OPINION OF APRIL 28, 1975;
- (II) SUMMARY JUDGMENT ON THE GROUND OF MISUSE;
- (III) LEAVE TO APPEAL TO THE COURT OF APPEALS UNDER 28 U.S.C. § 1292(b)

Now comes plaintiff Wallace Clark & Company, Inc., by its attorneys, and moves this Court for an Order for Reconsideration and Clarification of this Court's Opinion of April 28, 1975; Summary Judgment on the Ground of Misuse; and Leave to Appeal to the Court of Appeals under 28 U.S.C. § 1292 (b).

Respectfully submitted,



Paul H. Blaustein
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Attorneys for Plaintiff

Dated: New York, New York
May 8, 1975

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

FILED
U.S. DISTRICT COURT
S.D. N.Y.
JUL 21 4 27 PM '75

----- x
WALLACE CLARK & COMPANY, INC., :

Plaintiff, :

-against- :

ACHESON INDUSTRIES, INC., :

Defendant. :

74 Civil 2812

OPINION

#42826

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MICROFILM

JUL 22 1975

EDWARD WEINFELD, D. J.

Plaintiff, Wallace Clark & Company, Inc.

("Wallace Clark"), moves (1) for reconsideration and clarification of the court's opinion of April 28, 1975, denying plaintiff's motion for summary judgment and holding that a prior consent decree between the parties adjudicating the validity of the defendant's patent and its infringement by plaintiff's product, Meta-Tef 530, is to be accorded res judicata effect; (2) for leave to appeal the adjudicated order pursuant to 28 U.S.C., section 1292 (b); (3) to dismiss the second counterclaim of the defendant, Acheson Industries, Inc. ("Acheson"); and (4) for summary judgment upon its second cause of action.

1.

The court's holding is precise and requires no clarification. The holding that "the consent decree entered in the prior action between the parties is to be accorded res judicata effect with respect to the adjudication of (1) the validity of the patent, and (2) infringement of the patent by plaintiff's product Meta-Tef 530" does not foreclose, as the opinion specifies, "plaintiff

from asserting non-infringement of defendant's patent by other products manufactured by it, which products were not the subject of the prior consent decree." The motion for reconsideration and clarification is denied.

2.

As to plaintiff's motion for leave to appeal from the aforesaid order pursuant to 28 U.S.C., section 1292 (b), it is true, as this court acknowledged, that its holding on a controlling question of law is at variance with that of other courts. It is evident that an immediate appeal may materially advance the ultimate determination of this litigation. However, the court is of the view that in the circumstances of this case, it is preferable to facilitate an appeal by certification under Rule 54 (b) of the Federal Rules of Civil Procedure as to the third count of the complaint, which challenges the validity of the patent. (1) Given the court's earlier opinion, there is no just reason for delay in the entry of judgment in favor of defendant, since plaintiff is barred by the doctrine of res judicata from contesting

(1) See Gumer v. Shearson, Hammill & Co., Dkt. Nos. 74-1643, 74-2193 (2d Cir. Dec. 16, 1974).

the issue of validity. The court's ruling precludes plaintiff from raising any factual or legal issue as to the validity of the patent in the remaining counts of the complaint. The court therefore directs entry of judgment in defendant's favor as to the third count of the complaint pursuant to Rule 54(b).

3.

Under its second counterclaim, defendant alleges that plaintiff is in contempt of the consent decree entered into between the parties on October 6, 1972, which adjudicated the validity of the defendant's patent and its infringement by plaintiff's manufacture, use and sale of its product Meta-Tef 530. As part of the settlement of the earlier lawsuit, the parties entered into a licensing agreement which the decree notes in dismissing the action. The plaintiff made royalty payments until January 1, 1974, when it discontinued making them. This action followed, in which it contends that it "has the right to and has cancelled said license agreement."

The defendant's second counterclaim reiterates the allegations of its first counterclaim that plaintiff

3.

has breached their contract and alleges that this breach constitutes a contempt of the consent decree. Civil contempt is for the remedial purpose of compelling obedience to an order of the court for the purpose of enforcing

(2) another party's rights. In the usual patent case, the consent decree upon which it is sought to hold the alleged infringer in contempt contains an express injunction against any further infringement of the patent. (3) Here, however,

the consent decree did not enjoin plaintiff from infringing defendant's patent by the manufacture, use and sale of its product Meta-Tef 530. It simply stated that "the plaintiff having taken a license under defendant's" patent, the action was dismissed. It contains no injunction whatsoever.

A breach of the license agreement does not constitute

(2) *Chillitani v. United States*, 384 U.S. 364, 368 (1966); *Gompers v. Buck's Stove & Range Co.*, 221 U.S. 418, 449 (1911); *International Business Machines Corp. v. United States*, 493 F.2d 112, 115 (2d Cir. 1973), cert. denied, 416 U.S. 995 (1974).

(3) See, e.g., *American St. Gobain Corp. v. Armstrong Glass Co.*, 434 F.2d 1216 (6th Cir. 1970); *Crane Boom Life Guard Co. v. Saf-T-Boom Corp.*, 362 F.2d 317 (8th Cir. 1966), cert. denied, 386 U.S. 908 (1967); *Siebring v. Hansen*, 346 F.2d 474 (8th Cir. 1965), cert. denied, 382 U.S. 943 (1967); *Hopp Press, Inc. v. Joseph Freeman & Co.*, 323 F.2d 636 (2d Cir. 1963); *Botsolas v. Schultz Lab.*, 351 F. Supp. 188 (C.D. Calif. 1972). See also *Union Tool Co. v. Wilson*, 259 U.S. 107 (1922).

contempt of court absent an injunctive provision for its compliance. Thus, whether the license agreement is in effect or has been terminated, plaintiff cannot be held in contempt of the consent decree since there is no outstanding court order directed to plaintiff. (4)

Plaintiff's motion to dismiss the defendant's second counterclaim is therefore granted.

4.

Finally, plaintiff moves for summary judgment on its second cause of action, alleging that the provisions of the licensing agreement constitute a patent misuse. It relies upon two provisions in the license agreement that the licensee (plaintiff) may not terminate the agreement prior to the patent's expiration on March 21, 1978. Plaintiff contends that the combination of these provisions and the minimum royalty clause extinguishes the right of a licensee under Lear, Inc. v. Adkins (5) to avoid royalty

(4) See 18 U.S.C. § 401(3); *In re LaMarre*, 494 F.2d 753 (6th Cir. 1974).

(5) 395 U.S. 653 (1969).

5.

payments by proving that the patent is invalid. (6) It urges, without citing supporting authority, that this is a patent misuse.

The licensing agreement was entered into more than three years after Lear was decided. The effect of Lear was to render unenforceable any license agreement provision that attempts to prevent the licensee from contesting the validity of the patent as a defense to (7) an action by the licensor to enforce the license agreement. Thus defendant could not resuscitate licensee estoppel by this or any other language. The plaintiff concedes that a

- (6) As to the royalty provision, the Supreme Court has noted: "It is generally the rule that licensees may avoid further royalty payments, regardless of the provision of their contract, once a third party proves the patent is invalid." Lear, Inc. v. Adkins, 395 U.S. 653, 667 (1969). See also Troxel Mfg. Co. v. Schwinn Bicycle Co., 465 F.2d 1253, 1255 (6th Cir. 1972) and 489 F.2d 968 (6th Cir. 1973), cert. denied, 416 U.S. 939 (1974); Drackett Chem. Co. v. Chamberlain Co., 63 F.2d 853, 855 (6th Cir. 1933); 4 Deller's Walker on Patents § 404 (2d ed. 1965). But see Scherr v. Difco Labs., Inc., 401 F.2d 443 (6th Cir. 1968).
- (7) Bendix Corp. v. Bax, Inc., 471 F.2d 149 (7th Cir. 1972), cert. denied, 414 U.S. 819 (1973); Panther Pumps & Equip. Co. v. Hydrocraft, Inc., 468 F.2d 225, 231 (7th Cir. 1972), cert. denied, 411 U.S. 965 (1973); Massillon-Cleveland-Akron Sign Co. v. Golden State Adv't Co., 444 F.2d 425, 427 (9th Cir.), cert. denied, 404 U.S. 873 (1971).

minimum royalty provision is not per se illegal, but urges that the combination of it and the clause barring cancellation of the license until expiration of the patent "in effect amounts to an estoppel to challenge validity."

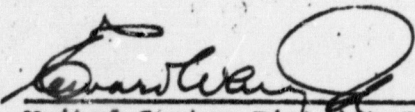
While it is true that under this court's ruling the consent decree is to be accorded res judicata effect as to the issues of validity and infringement, the provisions of the license agreement, qua agreement, would not preclude plaintiff from contesting the validity of the patent, as opposed to restricting plaintiff from unilaterally cancelling the agreement during its existence. Those contractual provisions by themselves do not and could not destroy the force of Lear. As this court noted in its prior opinion, the parties were represented by the same experienced lawyers who now represent them when the license agreement was entered into as part of the settlement which included the consent decree. They were, of course, familiar with Lear and its holding, and it is difficult to impute to them the intent to do a futile act.

Even if it were assumed that the license agreement

seeks to prevent plaintiff from challenging the patent's validity, the inclusion therein of this unenforceable (8) provision does not constitute patent misuse.

Plaintiff's motion for summary judgment as to its second cause of action alleging patent misuse is denied.

Dated: New York, N. Y.
July 21, 1975


United States District Judge

(8) Bendix Corp. v. Balax, Inc., 471 F.2d 149, 157-58 (7th Cir. 1972), cert. denied, 414 U.S. 819 (1973); Panther Pumps & Equip. Co. v. Hydrocraft, Inc., 468 F.2d 225, 230-32 (7th Cir. 1972), cert. denied, 411 U.S. 965 (1973); Congoleum Indus., Inc. v. Armstrong Cork Co., 366 F. Supp. 220, 232-34 (E.D. Pa. 1973), aff'd, 510 F.2d 334, 336 (3d Cir. 1975); Blohm & Voss A.G. v. Prudential-Grace Lines, Inc., 346 F. Supp. 1116 (D. Md. 1972), rev'd on other grounds, 489 F.2d 231 (4th Cir. 1973), cert. denied, 419 U.S. 840 (1974).

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

-----X
WALLACE CLARK & COMPANY, INC. :
 :
Plaintiff, :
 :
-against- :
 :
ACHESON INDUSTRIES, INC., :
 :
Defendant. :
-----X

74 Civil 2812

JUDGMENT AND ORDER

Plaintiff, Wallace Clark & Company, Inc. having moved:

(1) for reconsideration and clarification of the Court's opinion and order of April 28, 1975;

(2) for leave to appeal the adjudicated order pursuant to 28 U.S.C., section 1292(b);

(3) to dismiss the second counterclaim of the defendant, Acheson Industries, Inc.; and

(4) for summary judgment upon plaintiff's second cause of action.

And the Court having filed its opinion thereon on July 21, 1975;

NOW THEREFORE:

It is ORDERED that the motion for reconsideration and clarification of the opinion of April 28, 1975 is denied.

It is certified that there is no just reason for delay in entry of judgment in favor of the defendant dismissing the third count of the complaint and the Court having expressly directed the entry of judgment as to the third count of the complaint pursuant to Rule 54(b), and it is ADJUDGED that the third count of the complaint is dismissed.

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It is further ORDERED that the motion for leave to appeal pursuant to 28 U.S.C., section 1292(b) is denied in view of the foregoing disposition under Rule 54(b).

It is further ORDERED that the second counterclaim of defendant is dismissed.

It is further ORDERED that plaintiff's motion for summary judgment is denied.

Dated: New York, N. Y.
August , 1975

United States District Judge

STIPULATION

It is stipulated that the foregoing judgment and order may be entered.

HOPGOOD, CALIMAFDE, KALIL,
BLAUSTEIN & LIEBERMAN, ESQS.

Dated: August , 1975

BY: Paul H. Blaustein
PAUL H. BLAUSTEIN, ESQ.
Attorneys for Plaintiff
60 East 42nd Street
New York, New York

PENNIE & EDMONDS, ESQS.

Of Counsel:

MICHAEL DINNIN, JR., ESQ.

HARNESS, DICKEY & PIERCE, ESQS.
1500 N. Woodward
Birmingham, Michigan

BY: James M. Foley
JAMES G. FOLEY, ESQ.
Attorneys for Defendant
330 Madison Avenue
New York, New York

A62

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

-----X
WALLACE CLARK & CO., INC.,
Plaintiff,

v.

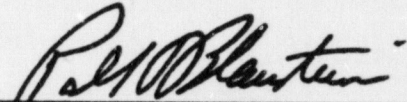
ACHESON INDUSTRIES, INC.,
Defendant.

Civil Action No.
74 Civ.2812 (EW)

-----X
NOTICE OF APPEAL

Plaintiff Wallace Clark & Co., appeals to the Court of Appeals for the Second Circuit from the Judgment And Order entered on August 12, 1975 in the above case based upon the decision of Hon. Edward J. Weinfeld on July 21, 1975.

Respectfully submitted,



Paul H. Blaustein
Hopgood, Calimafde, Kalil,
Blaustein & Lieberman
Attorneys for Plaintiff
60 East 42nd Street
New York, New York 10017

Dated: New York, New York
August 18, 1975

James G. Foley, Esq.
Pennie & Edmonds
Attorneys for Defendant
330 Madison Avenue
New York, New York

Michigan Circuit Court, Wayne County

ACHESON INDUSTRIES, INC. v. WALLACE
CLARK & Co., LTD.

No. 74-012650-CK

Decided Oct. 3 and Nov. 29, 1974

PATENTS**1. Jurisdiction of courts — Contracts and patent title (§43.15)****State courts — Jurisdiction (§63.3)**

State courts have jurisdiction for recovery of royalties where defendant pleads invalidity of patent; jurisdiction is upheld where right originally asserted is founded on a contract and even though a federal action is pending.

2. Prior adjudication — Infringement suits (§56.15)

Proposition that consent decrees have res judicata effect is qualified by public interest in obtaining a judicial determination of invalidity of worthless patent, unless it is clear that issue of validity was genuine in litigation resulting in consent decree; decree is not binding where there is no adjudication of validity and infringement; thus, decree stating that patent is valid and infringed is nothing more than an order granting a stipulated dismissal where it also states that decree may not be cited as an adjudication of contested issues.

3. Estoppel — As to validity — Licensor or licensee (§35.156)**Prior adjudication — Infringement suits (§56.15)**

Unless licensee is barred by res judicata finding of validity, it has right to challenge patent validity, even when license prohibits such conduct.

4. Estoppel — As to validity — Licensor or licensee (§35.156)**Title — Licenses — Termination — In general (§66.4271)**

Leary v. Adkins, 162 USPQ 1 (US SupCt), did not recognize a right of licensee to terminate license; instead, it held that licensee

may breach license through nonpayment of royalties knowing that it can raise invalidity as defense to suit for unpaid royalties.

Action by Acheson Industries, Inc., against Wallace Clark & Co., Ltd., for breach of patent license in which defendant counterclaims for declaratory judgment. On plaintiff's motion to compel answers to interrogatories. On defendant's motions for a stay and for summary judgment. Motions denied.

MICHAEL DINNIN, JR., and HARNESS, DICKEY & PIERCE, both of Birmingham, Mich., for plaintiff.

PAUL H. BLAUSTEIN and HOPGOOD, CALIMAFDE, KALIL, BLAUSTEIN & LIEBERMAN, both of New York, N.Y., and DALE R. SMALL and WHITTEMORE, HULBERT & BELKNAP, both of Detroit, Mich., for defendant.

MOODY, Circuit Judge.

This action is before the Court for a determination of four motions, three filed by Defendant and one filed by Plaintiff. The Defendant first moves for a stay of pleadings pending the determination of related matters in a New York Federal Court suit which was initiated after the instant action. In the alternative, summary judgment is requested as to the first and second counterclaim. Finally, the Defendant asks for a protective order preventing disclosure of confidential information as to its formulas and allowing Defendant's answers to certain of Plaintiff's interrogatories to stand. The Plaintiff's motion requests the Court to compel the Defendant to provide a more complete answer to the above mentioned interrogatories.

Jurisdiction

[1] This is an action for breach of contract and for an accounting. The contract in question is a License Agreement held by the Plaintiff. Federal statute vests the U. S. District Courts with original jurisdiction of any civil action arising under any Act of Congress relating to patents. Such jurisdiction shall be exclusive of the courts of the states in patent cases. 28 U.S.C.A. 1338. However, state courts have been held to have jurisdiction for recovery of royalties where Defendant pleaded the invalidity of the patent. *Ridgway v. Wetterhold*, 102 Kan. 217, 169 P. 1159 (1918). The jurisdiction of the state court is upheld where the right originally asserted is founded on a contract. *Wade v. Lawder*, 165 U.S. 624 (1897). Jurisdiction is in the state court even though a federal action is pending. *L. A. Young Spring & Wire Corp. v. Falls*, 293 Mich. 602 (1940).

Stay of Proceedings

Defendant asks this Court to stay its proceedings pending the outcome of a related declaratory action which the Defendant initiated in a New York Federal Court.

Wallace Clark argues that, since the License Agreement upon which this case is founded was entered into pursuant to a consent decree of the New York Court, there is just reason to allow that Court to make a determination as to whether the agreement or decree is binding on the parties. However, the contract in question is to be construed under Michigan law. The Court has jurisdiction to decide the issues and this jurisdiction has been invoked by the Defendant through its counterclaim. Therefore the motion to stay is denied without prejudice.

Summary Judgment

The Defendant's first counterclaim is for a declaratory judgment to determine Wallace Clark's right to contest the validity of Plaintiff's patent and its right to allege invalidity or noninfringement as a defense to the present claim for royalty payments. It is the Plaintiff's position that the consent decree entered into by the parties is res judicata on the Defendant as to the question of patent validity. Further, the res judicata doctrine should apply to the question of infringement to the extent the Defendant is still using META-TEF 530.

In Michigan a consent judgment is as binding as a judgment entered upon the Court's acceptance of one of two conflicting stories. *Bauer v. Township of Redford*, 367 Mich. 71, 116 N.W.2d 326 (1962). A consent decree, when signed by a Court, is a judicial act and possesses the same force and character as a judgment rendered following a contested trial. *Folqueras v. Hassle*, 331 F.Supp. 615 (1971). However, consent judgments are primarily acts of parties rather than considered judgments of the Court. *Ortiz v. Travelers Ins. Co.*, 2 Mich. App. 548, 140 N.W.2d 791 (1966).

[2] Consent decrees have res judicata effect. This general proposition is qualified only by some overriding principle, such as the public interest in obtaining a judicial determination of the invalidity of a worthless patent, unless it is clear that in the litigation resulting in the consent decree the issue of validity was genuine. 1B Moore's Federal Practice, Res Judicata Sec. 0.409, p. 1032 (2d ed.); *Addressograph-Multigraph Corp. v. Cooper*, 156 F.2d 483, 70 USPQ 272 (2d Cir. 1946).

Federal Courts have dealt with the res judicata effect of consent decrees in several patent cases. In *Addressograph*, supra, the parties entered into a consent decree concluding that the patent in question was valid. In a later infringement action between the same parties

the patent holder offered the consent decree as res judicata on the question of patent validity. The Court held that an adjudication of patent validity is inoperative unless it is accomplished by an adjudication of infringement. See *Business Forms Finishing Service, Inc. v. Carson*, 452 F.2d 70, 171 USPQ 519 (7th Cir. 1971); *Butterfield v. Oculus Contact Lens Company* 332 F.Supp. 750, 171 USPQ 527 (ND Ill. 1971); *Crane v. Aeroquip Corp.*, 364 F.Supp. 547, 179 USPQ 596 (ND Ill. 1973); and *Kraly v. National Distillers and Chemical Corp.*, 502 F.2d 1366, 183 USPQ 79 (7th Cir. 1974). This rule has been extended to its obvious conclusion in *Broadview Chemical Corp. v. Loctite Corp.*, 474 F.2d 1391, 177 USPQ 235 (2d Cir. 1973), where a prior consent decree, admitting validity and infringement, was held res judicata as to validity in a later infringement against a new line of products.

Now the consent decree entered in the instant case must be inspected to determine if it adjudicates the validity and an infringement of Acheson's patent. This judgment, dated October 6, 1972, was the result of a declaratory action initiated by Wallace Clark in a New York Federal District Court. The body of the consent decree reads as follows:

"CONSENT DECREE"

"As between the parties, by their counsel stipulating hereto, and the Court being fully advised in the matter, it is hereby ordered and decreed as follows:

"1. United States Letters Patent 2,976,257 in suit is valid and is infringed by plaintiff's manufacture, use and sale of its product Meta-Tef 530.

"2. The plaintiff having taken a license under defendant's United States Letters Patent 2,976,257, the above-entitled action is hereby dismissed, with each party to bear its own costs and attorney fees.

"3. This decree may not be cited as an adjudication of contested issues, nor be used for advertising purposes."

Granted, it does contain a statement that the patent in question is valid and further that Wallace Clark's manufacture, use and sale of Meta-Tef 530 infringed the patent. However, Paragraph 3 clearly limits the judicial effect of this decree. Case law requires an adjudication of validity and infringement before the consent decree will be binding. Paragraph 3 clearly reduces this consent decree to nothing more than an order granting a stipulated dismissal.

Plaintiff cites *PCR Golf Ball Co. v. Chemold Corp.*, 361 F.Supp. 187, 179 USPQ 660 (SD NY, 1973), as explaining the language of Paragraph 3. However, as Plaintiff notes in a footnote to his brief, the language used in PCR significantly differs from that used in this decree. It reads as follows:

"This decree cannot be cited against third parties as an adjudication of the contested issues as to invalidity of infringement; further, this decree cannot be used for advertising purposes."

The italicized portion is the only material deviation from the language used in the instant decree, but it is a fatal deviation. Therefore this consent decree adjudicates no issues. By the parties own request the Court has declined to grant res judicata status in this case. The earlier case rests as though it was settled out of court. The consent decree is not res judicata as to the issues of invalidity and infringement. The remaining question is whether the license entered into pursuant to settlement will estop Wallace Clark from contesting the validity of Acheson's patent.

[3] Wallace Clark has asked this Court to declare the License Agreement terminated. Apparently the Defendant believes that Clauses 14 and 16 of the License Agreement prevent Wallace Clark from challenging the validity of the patent. However, since *Lear v. Adkins*, 395 U.S. 653, 162 USPQ 1 (1969), a licensee clearly has the right to challenge patent validity, even when a license provision specifically prohibits such conduct. The only bar to such a challenge would be a res judicata finding of validity.

Defendant further asks this Court to declare that Wallace Clark has a right to terminate the License Agreement. The foundation of this argument is unclear. The Defendant has failed to cite authority for this proposition except to the extent of concluding that Clauses 14 and 16 of the License Agreement illegally prevent the Defendant from terminating during the life of the patent under *Lear*. In *Blonder-Tongue Laboratories v. University of Illinois Foundation*, 402 U.S. 313, 346, 28 L.Ed.2d 788, 809, 91 S.Ct. 1434, 169 USPQ 513, 526 (1971), the U. S. Supreme Court interpreted *Lear* as follows:

"*Lear* permits an accused infringer to accept a license, pay royalties for a time, and cease paying when financially able to litigate validity, secure in the knowledge that invalidity may be urged when the patentee-licensor sues for unpaid royalties."

[4] The Court did not recognize a right of the licensee to terminate the license. Instead, *Lear* means the licensee may breach the agreement through nonpayment of royalties knowing that now, post-*Lear*, he can raise invalidity as a defense to a suit for unpaid royalties. From the pleadings already filed in this action, it appears that Wallace Clark has already taken advantage of the *Lear* decision. It would appear at this time that enforcement of the License Agreement would be dependent upon the existence of a valid patent. See *Paul v. Col-*

lins, 191 Mich. 113 (1916); *Daniels v. Paradee*, 231 Mich. 251 (1925); *L. A. Young Spring and Wire Corp. v. Falls*, supra.

In conclusion, the request to declare the License Agreement terminated or that the Defendant has a right to terminate the agreement is denied. Defendant may nevertheless contest validity and infringement.

Protective Order Regarding Plaintiff's First Set of Interrogatories

Defendant's final motion is for a protective order regarding the following of Plaintiff's first set of interrogatories: 1(c)(d), 2, 3(d), 13(a)(b), and 14. Plaintiff has filed a corresponding motion to compel more complete answers to the same questions.

Question 1(c) has been sufficiently answered by Defendant.

Question 1(d) requests the formulation and ingredients of Meta-Tef 730. The License Agreement provides in Paragraph 11 that Defendant will disclose the recipe of #730 to Plaintiff's counsel on a lawyer confidential basis when the combined amounts of Meta-Tef 530 and Meta-Tef 730 require a royalty payment in excess of the yearly minimum payment.

Questions 1(d), 2 and 3(d) request information regarding the formulation and ingredients of various products manufactured by Defendant. Wallace Clark has answered these questions by indicating how its products individually differ from the claims stated in Plaintiff's patent. Wallace Clark has indicated the parties are dealing in a highly competitive field. It further claims that its formulas are trade secrets. In view of the foregoing the Court concludes that Defendant has answered these questions sufficiently at this time. Later on if Plaintiff shows sufficient cause and appropriately narrows its question, a further inquiry may be appropriate in this area that should require a reply. Otherwise, this Court is reluctant to order complete release of formulas.

As to questions 13(a)(b) and 14, this Court has concluded that the answers by Defendant are presently sufficient.

Nov. 29, 1974

Plaintiff's motion for reconsideration is denied. This Court will rely upon the reasoning of its prior determination including the holding of *Lear v. Adkins*, 395 U.S. 653, 162 USPQ 1 (1969). Nothing new has been raised by Plaintiff.

As a part of the prior consent decree the parties entered into an agreement or solemn contract which included the statement that said agreement "may not be cited as an adjudication of contested issues * * *". This is exactly what Plaintiff desires to do by its present position but agreed not to do.

The most obvious conclusion from such language would be if another lawsuit developed between the parties over their relationship, the prior consent decree would not be binding.

If a different meaning were intended than expressed as suggested by Plaintiff, then the parties should have said what was allegedly meant. This Court can only interpret what they did agree to in the consent decree.

In view of projected discovery, this Court would have no objection if Plaintiff desires to appeal from the instant ruling. Plaintiff may insert appropriate language to its proposed order.

6-10-11
JW
JW

STATE OF MICHIGAN
IN THE
CIRCUIT COURT FOR THE COUNTY OF WAYNE

ACHESON INDUSTRIES, INC.,

Plaintiff,

v.

Civil Action No. 74-012650 C.R.

WALLACE CLARK & CO., LTD.

Defendant.

For Plaintiff: Michael R. Dinnin (P-12801)

For Defendant: Dale R. Small (P-20599)
Paul H. Blaustein

STIPULATION OF DISMISSAL

It is hereby stipulated and agreed to between the
parties hereto, through their respective attorneys, that this action
is dismissed without prejudice.

By Michael R. Dinnin, Date: 3/5/75
Michael R. Dinnin
HARNESSE, DICKEY & PIERCE
1500 North Woodward Avenue
Birmingham, Michigan 48011
(313) 642-7000
Attorneys for Plaintiff

By Dale R. Small, Date: 3/5/75
Dale R. Small
WHITEMORE, HULBERT & BELKNAP
3053 Penobscot Building
Detroit, Michigan 48226
Attorneys for Defendant

IT IS HEREBY ORDERED THAT THIS
ACTION IS DISMISSED WITHOUT PREJUDICE.

Circuit Judge

Date

FILED
MAR 14 1975
Circuit Court for the County of Wayne
Detroit, Michigan

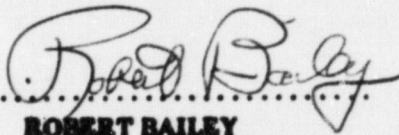
STATE OF NEW YORK)
) ss.
COUNTY OF RICHMOND)

ROBERT BAILEY, being duly sworn, deposes and says, that deponent is not a party to the action, is over 18 years of age and resides at 286 Richmond Avenue, Staten Island, N.Y. 10302. That on the 1 day of October, 1975 deponent served the within appendix upon PENNIE & EDMONDS

~~attorney(s) for~~ attorneys for defendant Acheson Industries

in this action, at 330 Madison Avenue, NYC 10017

the address(es) designated by said attorney(s) for that purpose by depositing 3 true copies of same enclosed in a postpaid properly addressed wrapper, in an official depository under the exclusive care and custody of the United States post office department within the State of New York.

.....

ROBERT BAILEY

Sworn to before me, this
1 day of October, 1975.


WILLIAM BAILEY

Notary Public, State of New York
No. 43-0132945

Qualified in Richmond County
Commission Expires March 30, 1976